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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1968

NO. 1005

EARL E. HOWE,

Petitioner,

vs.

GENERAL MOTORS CORPORATION,

Respondent.

OPINIONS OF COURTS BELOW AND STATUTES ACCOMPANYING PETITION FOR WRIT OF CERTIORARI

INDEX

	Pages
OPINIONS OF COURTS BELOW	
1. By Judge Picard in Howe v. Attorney, 47 F. Supp. 979 - 990 (E. D. Mich., S. D., October 7, 1942)	1 - 9
2. By Judge LaBuy in suit at bar, 54 C 1893, 167 F. Supp. 330 - 336 (N.D.Ill., E.D., October 17, 1958); P.A. 51 - 62	10 - 21
3. By Judge Perry in suit at bar, 54 C 1893, Unreported, (N.D.Ill., E.D., September 29, 1961) denying GM motion to vacate his order granting Howe new trial; D.E. III 2155 - 2160	22 - 27
4. By Judge Robson in suit at bar, 54 C 1893, 252 F. Supp. 924 - 938 (N.D.Ill., E.D., April 5, 1966); P.A. 708 - 737	28 - 57
5. By Court of Appeals for Seventh Circuit, Nos. 15841-42, 401 F. 2d 73 - 79, July 15, 1968)	58 - 68
UNITED STATES CODE	
Title 5. Administrative Procedure Act, secs. 1; 597; 1001; 1009.	69
Title 35. Patent Act of 1952, secs. 101; 102; 103; 141; 145; 282.	69 - 70

Action for royalties by Earl E. Howe against Seth B. Atwood, Helen Atwood, his wife, James T. Atwood and Myra C. Atwood, his wife, individually and doing business as the Atwood Vacuum Machine Company, not registered, who filed a counterclaim for damages caused by garnishment proceedings, and wrongful termination of license contract.

Order in accordance with opinion.

Alex J. Groesbeck and Lawrence Rothenberg, both of Detroit, Mich. (Clarence B. Zewadski, of Detroit, Mich., of counsel), for plaintiff.

Beaumont, Smith & Harris, and Albert E. Meder and Richard W. Larwin, all of Detroit, Mich. (Andrew F. Wintercorn, of Rockford, Ill., of counsel), for defendants.

PICARD, District Judge.

The chronological history becomes important.

March 15th, 1937, plaintiff filed application for United States letters patent, No. 130977, entitled "Hinge Mechanism" and covering a practical concealed hinge for supporting a curved door to a curved automobile body. During that year he submitted his ideas to the several companies making hinges for Ford, Chrysler, General Motors and for other independent automobile concerns. He showed defendant Seth B. Atwood, manager of defendant the Atwood Vacuum Machine Company, his application including requested claims, but defendants were not interested. Later application No. 130977 was abandoned because of the death of plaintiff's patent attorney but the identical application was refiled January 14th, 1938, for which plaintiff on June 20th, 1939, received letters patent No. 2163323 (hereinafter referred to as 323 or Patent No. 1).

March 16th, 1938, plaintiff entered into an option agreement with Metal Specialty Company of Cincinnati, Ohio, by the terms of which Metal Specialty had the right to become licensed under Howe's ideas covered by the terms of a proposed license agreement which was attached to the option. This option was exercised and the license agreement executed May 24th, 1939, by which plaintiff granted Metal Specialty exclusive license to manufacture, sell and use the inventions evidenced by then numbered application 130977, all continuations and substitutions therefor, all divisions thereof, and under any and all patents and reissues thereof which licensor might apply for and obtain or otherwise acquire in concealed hinges and body arrangements, during the life of the agreement. Patent No. 2 herein later mentioned was applied for during the option period and became a part of the license. Licensee agreed to pay plaintiff 5 percent of the sales price received by it for hinges sold pursuant to the contract and licensee had the right to grant sub-licenses, a royalty of 5 percent of the sale price received from such sub-licensees to be collected by licensee and paid to licensor.

Plaintiff and Metal Specialty sought to interest many automobile and body building companies in patent 323. During 1938 they showed plaintiff's hinge to Studebaker, General Motors, Ford, Chrysler, Nash, Budd, Packard, Fisher Body and gave evidence that at the same time they showed a compensating angle or inclined pin hinge construction which Howe stated he had conceived and put on a blue print as far back as August 23rd, 1937. He produced this blue print.

In May, 1938, Howe prepared a model showing the inclined pin hinge which he also demonstrated during the same year to several automobile and body companies.

May 10th, 1938, Howe was given a hinge layout by a Mr. Sullivan, engineer for Studebaker, and on the 19th gave that engineer a drawing showing the inclined pin.

On January 9th, 1939, plaintiff filed his application for his second hinge with the inclined pin, and on May 21st, 1940, received letters patent No. 2,201,490 (hereinafter referred to as 490 or Patent No. 2).

Of all companies approached, Packard seemed to be the most interested in the Howe hinge and Packard was one of defendant company's customers. While patents were pending conferences were held between Metal Specialty Company, plaintiff and defendant company during which the subject matter contained in the applications and possible coverage to be obtained were discussed.

April 19th, 1939, less than four months after plaintiff had made application for his inclined pin hinge, a contract was entered into between Metal Specialty and Atwood Vacuum by which they were both to make hinges covered by the patents applied for (323 and 490) and to divide "the production and profit" "equally between them". Atwood Vacuum was to pay Metal Special-

$1,000.00 upon signing the contract and an additional $1,000.00 after satisfactory claims had been allowed. Atwood Vacuum was also to pay Metal Specialty 5 percent of the sales price on hinges until an additional sum of $4,000.00 was paid. This was to equalize development expenses. It was further provided that payment of the 5 percent royalty on hinges sold and manufactured by Atwood Vacuum be paid direct to plaintiff and this was a different arrangement than plaintiff had with Metal Specialty. Plaintiff approved and consented to this agreement in writing. In other words, plaintiff agreed to look to Atwood Vacuum for royalties on his hinges sold by defendant company and in that contract Atwood Vacuum agreed not to contest "directly or indirectly or in any way encourage or lend assistance to anyone intending or attempting to contest the validity of the patents licensed thereunder."

Atwood Vacuum agreed to aid in securing the claims and did make one or two helpful suggestions.

Atwood Vacuum then paid $2,000.00 to Metal Specialty Company "in equalization of the development expenses up to date".

Shortly thereafter Metal Specialty complained that certain hinges which it felt came within the scope of the above agreement on both patents were being made by Atwood Vacuum for Studebaker and asked Atwood Vacuum to account for royalties and excess profits. In reply defendant company claimed the hinge it had sold Studebaker did not infringe the Howe patents and several letters were exchanged between the parties, defendants warning Metal Specialty that the validity of their joint patents might be challenged by the big automobile companies if it insisted upon pushing the matter. Later, May 24th, 1940, Metal Specialty Company notified defendant company that it was terminating the April, 1939, contract at the end of 30 days but Atwood Vacuum prevailed upon it to reconsider and talks were had without any further action on the termination. However, upon continued refusal of defendant company to pay royalties to Howe and to divide the production and profits, Metal Specialty Company, September 24th, 1940, assigned all its rights, title and interest in and to said April 19th, 1939, agreement to plaintiff and was released by plaintiff from further obligation, Metal Specialty notifying defendant company of its action October 1st, 1940.

October 3rd, 1940, defendant company acknowledged receipt of that assignment asking in reply whether "any further work that we may have to do would then be done with Howe?"

October 8th, 1940, Metal Specialty wrote defendants "so any further work that you have to do should be done with Earl Howe".

January 9th, 1941, three months later, defendants notified Metal Specialty Company that they considered Metal Specialty's action in assigning their contract to plaintiff, a breach of the April 19th, 1939, agreement, absolutely of no force or effect, and demanding return of the $2,000.00 they had paid.

On March 5th, 1941, Howe started suit against defendants in the Wayne County Circuit Court under the license agreement for royalties and as assignee of Metal Specialty for the agreed sum of $4,000.00 and excess profits, and service was made on defendants March 18th, 1941.

March 21st, 1941, after suit and service, more than five months after first being notified of the assignment to Howe and more than two months after repudiating that assignment, defendant company wrote Earl E. Howe "We do not consider ourselves a licensee and that so far as we were concerned we had no interest whatever in the patents which you controlled. This letter will serve legal notice that we are not a licensee under Howe patents on hinges as covered on the original contract between yourselves and Metal Specialty Company."

Defendants immediately removed the cause to this court, whereupon plaintiff filed an amended bill adding prayers to hold defendants as infringers; to enjoin defendants from manufacturing further hinges covered by plaintiff's patents 323 and 490, and asking that defendants be directed to account and pay plaintiff all sums found due him on account of breach of the contract of April 19th, 1939.

The Issues Involved.

Several questions are presented:

First Question.

The first for this court to decide is whether plaintiff may maintain an action on the April 19th, 1939, contract, for royalties.

Metal Specialty Company admittedly was not then manufacturing hinges of any kind

while Atwood Vacuum was well known in this line. Atwood Vacuum, interested in the Howe hinge because one of its clients, Packard, was interested, learned it had to do business with Metal Specialty. It was not necessary under the license granted Metal Specialty for Howe to become party to any contract of sub-license but evidently as a precaution for all parties, the arrangement between Metal Specialty and Howe was modified to the extent that Atwood Vacuum was to make payments direct to Howe. Thus the contract became a three party agreement and it is the opinion of this court that this arrangement not only served Howe's purpose well but it was also of value to Atwood Vacuum in the event that some difficulties arose later between itself and Metal Specialty. This contract being participated in by Howe gave the Atwood company a hold upon Howe it otherwise would not have had.

It will also be noted that when Metal Specialty informed defendant in October of its assignment to Howe, defendants then replied that they understood they must henceforth do business with Howe. It took defendants three months before notifying Metal Specialty that they questioned Metal's right to make any such assignment and five months to apprise Howe of their claimed status of non-licensee. And then only after plaintiff had brought suit and defendants had been served.

[1-3] Approaching this from the opposite angle we believe that if plaintiff had refused to go on with this contract while defendants had lived up to their obligations, defendants certainly could have resorted to action on this agreement and gotten favorable results. But for reasons best known to themselves, in March, 1941, they chose to strike the shackles by which their company was encumbered under the terms of that agreement. This contract was plain and unambiguous and leaves no reason for strained construction. Defendants should not therefore be permitted to show an intent contrary to its express provisions. As stated in Golden Gate Bridge & Highway District v. United States, 9 Cir., 125 F.2d 872, 876, "the cardinal rule of construction is to ascertain and give effect to the intention expressed in the instrument which is being construed" citing 12 Am.Jur., Contracts, § 227. See, also, Harrington v. Interstate Business Men's Association, 210 Mich. 327, 178 N.W. 19. To this court it appears that all three were parties to that agreement and that plaintiff may now maintain this action for royalties.

The date of "cancellation" of that contract, however—if cancelled—will be discussed later.

Second Question.

We come now to the second issue, to-wit:

May defendants question the validity of these patents in a suit for royalties?

[4] It is admitted that the Federal Court has exclusive jurisdiction of infringement of patents, 28 U.S.C.A. § 371, Fifth, and that this was originally a suit for royalties and not for infringement. Does removal to the Federal Court enlarge the scope of the justiciable issues so that validity of the patents may now be attacked? We think this is answered in a very recent decision, Noma Electric Corporation v. Polaroid Corporation from the Southern District of New York, 2 F.R.D. 454, decided May 22, 1942, where the court stated: "If the state courts lacked jurisdiction over the subject matter of the action, the federal courts cannot acquire jurisdiction as the result of the removal, although it might have had jurisdiction if the action had originally been commenced in the federal court".

In State of Minnesota v. United States, 305 U.S. 382, 59 S.Ct. 292, 295, 83 L.Ed. 235, Mr. Justice Brandeis says: "If Congress did not grant permission to bring this condemnation proceeding in a state court, the federal court was without jurisdiction upon its removal. For jurisdiction of the federal court on removal is, in a limited sense, a derivative jurisdiction. Where the state court lacks jurisdiction of the subject matter or of the parties, the federal court acquires none, although in a like suit originally brought in a federal court it would have had jurisdiction."

[5] Here, however, plaintiff amended his own bill of complaint asking injunction against further infringement. May he not then voluntarily enlarge the scope of the jurisdiction? The answer we believe is correctly given above and in De Lima v. Bidwell, 182 U.S. 1, 174, 21 S.Ct. 743, 744, 45 L.Ed. 1041, where the court states: "Defendant neither gains nor loses by the removal, and the case proceeds as if no such removal had taken place."

Both State of Minnesota v. United States and Noma Electric Corporation v. Polaroid Corporation, supra, were decided subsequent to adoption of the new civil rules, so it is apparent that those rules neither extended nor limited jurisdiction of the district court. In fact, they so provide, Rule 82, 28 U.S.C.A. following section 723c.

[6] Therefore, insofar as these defendants are concerned, the question is not "Are plaintiff's patents good" but, first, just what is the proper construction of the patent issued plaintiff, and second, has defendant company made and sold a hinge that bears more closely upon the patented article than it does upon the prior art? Baldwin Rubber Co. v. Paine & Williams Co., 6 Cir., 99 F.2d 1; Casco Products Corp. v. Sinko Tool & Mfg. Co., 7 Cir., 116 F.2d 119, 121.

[7] In short, if defendant company is manufacturing substantially the hinge covered by plaintiff's patent which in turn is not covered by the prior art, then regardless of the validity of plaintiff's patent, defendants must pay royalties and as licensees are estopped from questioning the validity of patents under which they have licensed while this contract remained in full force and effect. Not only do defendants so specifically agree in their contract but the weight of authority is overwhelming. Baldwin Rubber Co. v. Paine & Williams Co., 6 Cir., 99 F.2d 1; Motor Wheel Corp. v. Rubsam Corp., 6 Cir., 92 F.2d 129.

[8] And it has been held that even though the claims are given the narrowest construction possible and even though the devices are changed to some extent, if they remain the equivalent of the invention, that is if they perform substantially the same function in substantially the same way to obtain the same results, there is infringement. Baldwin Rubber Co. v. Paine & Williams Co., supra; Motor Wheel Corp. v. Rubsam Corp., supra; General Tire & Rubber Co. v. Fisk Rubber Corp., 6 Cir., 104 F.2d 740.

Third Question.

The third question—Is plaintiff entitled to recover under his patent 323 for hinges manufactured and sold by defendants to the Studebaker Company which defendants claim are covered entirely by the prior art?

The evidence shows that when application was made for patent 323 petitioner, plaintiff here, had to elect whether he was asking a patent on a hinge per se or whether it was a type of hinge in combination with the door of an automobile.

Plaintiff's patent mechanism is known as a concealed hinge, that is it cannot be seen from outside the car. It was designed to be placed about halfway the height of the door and was limited in length, the top of the hinge being about the lower most edge of the door window, and the bottom substantially above the lower edge of the door. It had one pintle. It was one hinge. And when petitioner was confronted with a similar hinge covered by Citrain British 8460 but having two pintles, he contended that while his was a "unitary" type hinge with a "single" pintle, the Citrain British device was a "duplex unitary" hinge with "two" pintles. Since both Citrain British and Howe's hinge worked on a fixed axis he differentiated between the two only on the theory that his hinge with a single pintle was superior to the Citrain British hinge because it would not get out of alignment. He insisted that any hinge having two pintles (Citrain 8460) was the complete equivalent of two hinges and would not have the advantage of a single hinge, specifically adding that "any attempt to align the door after hanging (with the Citrain British 8460) will result in throwing the pins out of line and thus a major and essential advantage of applicant's hinge will be lost." Words in parenthesis added.

[9] Thus, he defined to the examiner the advantage of his hinge over the upper half of the Citrain hinge. This is important because by the file wrapper and by what took place before the examiner we can determine on what distinction applicant was asking to receive his patent. Alliance Securities Co. v. De Vilbiss Co., D.C.Ohio, 24 F.2d 530, 532; Jones et al. v. General Fireproofing Co., 6 Cir., 254 F. 97, 101; Grever v. United States Hoffman Co. et al., 6 Cir., 202 F. 923, 926; Banning v. Sears, Roebuck & Co., 6 Cir., 88 F.2d 45, 47; Wiegand v. Bingham Co., 6 Cir., 106 F.2d 546, 548.

There is no denying that plaintiff has claims to what was known as a combination of hinge, door and body in his first patent and he so elected. Then when he revas ped

his application and accompanying claims he was confronted by Citrain French patent 446509, also a duplex unitary hinge. This time applicant differentiated between his mechanism and that of the Citrain French patent and Swallow British patent 462033, cited by the examiner, to explain that his hinge worked on a "fixed axis" —that is the pintle did not move, while in both the Citrain French and Swallow British patent cited, the hinge pin did move as the door was opened and closed.

One cannot read plaintiff's claims and history of his first patent without reaching the conclusion that applicant claimed nothing more than a concealed hinge having a single pin, of limited length, placed at a certain part of a curved automobile door with the top of the hinge about even with the window line. It was strictly a one pintle hinge—the sole distinction advanced by him between it and the Citrain British patent and undoubtedly the only reason the Citrain British hinge was not further considered by the examiner was that Howe when he revamped his application voluntarily limited his claims to a unitary single pintle hinge. This is the more apparent by his resorting to the distinction of a "fixed axis" between his hinge and the Citrain French and Swallow British patents when he reappeared before the examiner with his new claims.

[10] These two patents long antedated the Howe patent. The mechanism made by defendant company on which royalties are now demanded based on patent number one is practically an exact reproduction of the top Citrain British hinge. It has two hinge pins, a fixed axis and is concealed. It never was the intent of the examiner in our opinion to give plaintiff a patent on the duplex unitary hinge nor did plaintiff ever claim it. In view of the above it should not be so construed. Anybody can make that Citrain hinge now without infringement and there was no infringement by defendants in selling Studebaker the hinge known as Exhibit 8. The mechanism was entirely covered by the prior art and so plaintiff is not entitled to royalties on his first patent. Casco Products Corp. v. Sinko Tool & Mfg. Co., supra.

Fourth Question.

The next question relates to the second or "inclined Hinge" patent, which in general details is the same as the location or combination hinge except that patent 490 is a hinge with an inclined axis and an inclined pintle. But here we must approach the issue from two separate angles because plaintiff claims that defendants made and sold a duplex unitary hinge that was practically a duplicate of Howe hinge 490 and then made and sold a second type of hinge which, in effect, was half of its duplex unitary hinge or the Howe hinge cut into two parts and designated by plaintiff as a single type hinge. This smaller or single type hinge was to be placed near the top of the car door and some other type hinge at the bottom—but wherever the accused hinge was used it aimed to give the same results with the same mechanism and in the same manner as the second Howe hinge.

The claims of plaintiff's patent No. 2 define a hinge per se. That is, it is a certain type hinge of itself. True, it's primarily a hinge to be used on a car door and illustrations all relate to automobiles, but it is the understanding of this court that the secret of the claims of the second hinge lies in the fact that the inclination of the axis inwardly from the car door and longitudinally towards the front of the car is accomplished by the use of an inclined pintle built into the hinge, this inclination being compensated for by using a goose-neck hinge member varying the extent of its curvature from top to bottom.

The evidence shows that even in the old style cars before streamline bodies, car doors were never always accurately aligned and fitted but had to be "persuaded" or "jimmied" into place. This was nothing new and was accepted by auto body manufacturers—the "persuasion" often bending the hinge so as to get the door into proper alignment. However, with the advent of the new style streamline bodies "persuasion" alone was out of possibilities. In addition it was desirous of having a door that would open parallel to the ground and at a certain angle would reach a neutral position where it would not fall back quickly striking the person about to enter the car, or fall forward towards the fender. To achieve this result manufacturers began shaping the pillar of the door so that when the common straight vertical pintle hinge was affixed it slanted inwardly and longitudinally—the Cord car of 1936, for example. Results were not entirely satisfactory and some persuasion was still necessary.

Plaintiff contends that he solved the problem. His claim is that he conceived the type of hinge that eliminated the neces-

sity of modifying the pillar which still by "persuasion" had to be twisted so that alignment could be made. Howe's second hinge, he says accomplished this without "persuasion".

It is not denied that defendants also knew the problem that had become exaggerated by the new streamline bodies when they entered into this contract and that they agreed to participate in helping to get the second patent with the claims based upon an inclined pintle and an inclined axis. Defendant company's manager, Atwood, had seen the drawings and what Howe claimed. But Atwood Vacuum, nevertheless, started making an inclined pintle hinge of a duplex unitary type practically exactly like the Howe hinge but having two pintles instead of one. Later it made a single type hinge to go at the top of the door and to be used with some other type hinge near the bottom but with the axis inclined and the pintle in each hinge also inclined.

Let us first discuss the duplex unitary hinge.

[11] Defendants' claim simply is that Howe's patent merely covers a single pintle and that the examiner having had experience with the first Howe hinge knew Howe was claiming on a single hinge. Furthermore defendants allege that the claims of the second patent as written particularly emphasize that it was a single pintle and not two. But each patent is a separate contract with the government and what Howe said in securing his first patent should not be held against him in getting a patent on an entirely different hinge. Deitel v. Unique Specialty Corp., 8 Cir., 54 F.2d 359, 360; Lewis Blind-Stitch Mach. Co. v. Arbetter Felling Mach. Co., D.C., 208 F. 992.

[12] However, what is more important is that the drawing accompanying the second Howe hinge shows how it could be utilized with two pintles as well as one, and incidentally one of the arguments used by defendants in limiting Howe's first patent was that his drawings did not cover a duplex (two pintle) hinge. But Howe's drawing in the second patent did—and the drawings accompanying a patent with its claims are illuminating when the question of prior art and intended coverage is at issue. Wadsworth Electric Mfg. Co., Inc., v. Westinghouse Electric & Mfg. Co., 6 Cir., 71 F.2d 850, 852; Whitin Mach. Works v. Houghton, 1 Cir., 178 F. 444.

Defendants then produced Smith patent No. 2050469 which is also a concealed hinge mechanism for a car door where the axis of the hinge is inclined, there being two separate hinges—one at the top and one at the bottom of the car door, the hinge itself being a ball and socket arrangement. They insist that as owner of the Smith patent they had the first inclined axis theory so that plaintiff cannot claim this feature of his hinge as being new and that since the "pintle" is old in the art this was not sufficiently distinguishable from the ball and socket mechanism to be patentable.

However, using the same theory to acquaint ourselves with the scope of the Smith patent as we did in determining the scope of Howe's No. 1. hinge, we find the following significant wording used as part of the Smith patent: "It is common practice to use hinges of the pintle type in mounting the doors on vehicle bodies, *but such hinges require the pintles to be in alignment, and on the modern vehicle bodies that usually means one or more of the hinges must extend laterally outward beyond the surface of the body to such an extent as to afford considerable air resistence to the rapid transit of the vehicle.*" (Italics ours.)

Thus we find the Smith patent distinguishing its "ball and socket" feature on an inclined axis as accomplishing a result not obtainable by "pintles" and insisting that pintles could not be used on the new doors without at lease one or more of the hinges being exposed and adding that alignment was difficult. In practice, however, defendants found that their own Smith hinge was not feasible because the Smith ball and socket arrangement would not support a heavy car door and discontinued its manufacture.

We do not question that the Smith patent was a pioneer in the inclined axis hinge type but there is more to the Howe hinge than an inclined axis. The pintles themselves are inclined. Even in the drawing accompanying the second hinge in which there are two pintles, both the top and bottom pintles are inclined in complete alignment. The claims are all specifically based on an inclined pintle built into the hinge and Claims 3 and 4 are additionally based on a goose-neck hinge member of substantial curvature varying the extent of curvature from top to bottom to compensate for the inclination of the pintle.

[13] Defendants have failed to show any inclined pintle as part of any hinge for automobile doors in the prior art and even without the drawing showing a duplex unitary hinge (which plaintiff does show in patent No. 2) if, when slight changes or deviations from the patented article have been made, the new device still uses the same mechanism to obtain the same results, the licensor can collect on his contract after the prior art has not disclosed a device of the same type. Baldwin Rubber Co. v. Paine & Williams Co., supra; General Tire & Rubber Co. v. Fisk Rubber Corp., supra.

[14] To this court it is apparent that the duplex unitary hinge with the inclined pintles made and sold by defendants is practically a duplicate of the hinge shown by the duplex unitary hinge drawing appearing in Howe's second patent and the same to all intents and purposes as the unitary hinge with one pintle of that same patent. And this court holds that the examiner and the government intended to give plaintiff a patent covering a hinge having a goose-neck type hinge member with an inclined axis and an inclined pintle. Therefore we find that even if defendants made and sold only half of the duplex hinge or only part of plaintiff's hinge, under the facts of this case plaintiff can recover for such hinges also meet all of the terms in the claims of the second patent. Dowagiac Mfg. Co. v. Superior Drill Co., 6 Cir., 115 F. 886.

[15] There was some evidence that General Motors had a drawing back in November, 1937, showing the inclined axis and evidently the inclined pintle, but Howe countered by presenting a previous drawing of the same year. The testimony of neither party is extremely convincing on this point. But General Motors' hinge was not proven to be more than an experimental drawing and the hinge never was used or known to the public prior to Howe's invention. Furthermore the evidence submitted does not satisfy the rule that prior knowledge or use of an invention must be proved beyond a reasonable doubt, or, by substantially such certainty. Westinghouse Elec. & Mfg. Co. v. Wadsworth Elec. Mfg. Co., 6 Cir., 51 F.2d 447, 449; Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co. (In re Barbed Wire Patent), 143 U.S. 275, 284, 12 S.Ct. 443, 36 L.Ed. 154; Eibel Co. v. Paper Co., 261 U.S. 45, 60, 43 S.Ct. 322, 67 L.Ed. 523.

There is also some evidence that the double inclination principle was in the 1937 Chevrolet car, the first showing of which was made in 1935. In fact, defendants claim that thousands of cars embodying the Howe patent were on the streets in 1937 except that the body tumbled out instead of in. But another distinction was that the hinges were exposed. Here the hinges are concealed and of the gooseneck type, undoubtedly patentable in itself. We believe it is fair to assume that if this idea was so prevalent in 1938 defendants should have known about it. Atwood vacuum was in the hinge business and we cannot understand their interest in plaintiff's hinge in 1939-40, particularly their desire to insure the proper scope of the claims, if such a hinge was already on the market.

[16] But in any event, did General Motors have a like mechanism? This would be a question of validity pure and simple, and does not release defendants from their obligation. Baldwin Rubber Co. v. Paine & Williams Co., 6 Cir., 99 F.2d 1.

For those hinges furnished by defendants, plaintiff may recover.

As to installations where two separate hinges are used, one at the top and one at the bottom, defendants contend that here again the file wrapper should be taken into consideration and that plaintiff stated before the examiner that claim 4, which defendants insist is the only claim under which this double hinge could be read, differed from claim one only because there was a single inclination. This, we believe, to be without merit.

[17] These cases are authority for the liberality of interpreting claim coverage when apparently limited by argumentative statements before the examiner. Kellogg Switchboard & Supply Co. v. Michigan Bell Telephone Co., D.C.Mich., 5 F.Supp. 118; Byers Machine Co. v. Keystone Driller Co., 6 Cir., 44 F.2d 283, 284; Parker Rust Proof Co. v. Ford Motor Co., D.C.Mich., 6 F.2d 649, 657.

Claim four reads as follows: "4. Means adapted to support the door of an automobile body curved in transverse section comprising a concealed hinge, said concealed hinge comprising a hinge plate, a gooseneck type hinge member of substantial curvature connected directly to said hinge plate, the axis of the connection being at an inclination to the vertical as required

by the curvature of the automobile body, said hinge member varying the extent of its curvature from top to bottom thereof in an amount sufficient to substantially compensate the inclination of said axis whereby a door carried by said hinge member swings through a substantially horizontal arc."

[18] In addition, in our opinion the Atwood single type hinge, when used with one or more additional hinges, is readable upon the first three claims of patent 490 and without the claimed limitation of the file wrapper, claim No. 4 specifically covers the accused hinge in such an installation. Since we hold that plaintiff's claims are not limited, plaintiff can recover under Copeman Laboratories v. General Motors Corp., D.C., 36 F.Supp. 755. The rights of the plaintiff should be broadly accepted and in the case at bar where is there any evidence of a hinge or hinges under any other patent or prior art which embodies the Howe inclined pintle and axis hinge type? We find none.

[19] It is our holding that where there were hinges with the pintles inclined and aligned on an inclined axis fitted upon a door or in a depression of the door pillar to obtain results of the Howe patent made and sold by defendant, plaintiff may recover. This we hold whether in a duplex unitary type or in a single type hinge.

We repeat that we are not passing upon the validity of the plaintiff's patents but defendants in our opinion have manufactured and sold these infringing hinges for use on automobiles made by the following companies: Studebaker Corporation, Chrysler Corporation, and Nash-Kelvinator Corporation that they are based fundamentally upon Howe patent No. 2 and for these plaintiff can recover.

Fifth Question.

[20] Defendants claim further that under no circumstances can they be held for royalties when they did not make or sell the hinges for any particular purpose and that if there has been infringement it has been by automobile companies utilizing these hinges.

We believe that this defense is also without merit. Certainly defendants knew for what these hinges were to be used. Atwood Vacuum was making hinges for automobile car doors—not for house doors, and it participated and gave first impetus to whatever infringement there might have been. Canda v. Michigan Malleable Iron Co., 6 Cir., 124 F. 486; General Electric Co. v. Sutter et al., C.C., 186 F. 637; Elevator Appliance Co. v. Brooks, 2 Cir., 101 F.2d 703.

Sixth Question.

The next question presented is to decide the effect of the assignment of September 24th, 1940. Defendants contend that the assignment is void and of no force and effect and cites authorities that a licensee cannot assign a license agreement without the contract expressly providing for assignment. The assignment here is by the licensor rather than the licensee. However, this court has already held that plaintiff may maintain this action as to royalties on the broader grounds, namely, that plaintiff, by consenting to the contract between Metal Specialty and Atwood Vacuum, became bound thereby as licensor and entitled to royalties from defendants as licensor. Therefore whether plaintiff is entitled to maintain an action on the assignment as to monies due Metal Specialty which had accrued to the date of the assignment and whether plaintiff can maintain an action for damages for profits made after the date of the assignment must be determined.

In this connection it might be well to note that Atwood Vacuum upon receiving the assignment of September 24th, 1940, recognized in its letter of October 3rd, 1940, that it must henceforth do business with Howe.

[21] Plaintiff claims that as assignee he is entitled to excess profits as defined in the agreement and 5 percent of the sales price of hinges not to exceed $4,000.00 which accrued to September 24th, 1940, and also damages for breach of contract for failure to divide the production and profits. This court holds first, that plaintiff is entitled to maintain an action on the assignment as to any money which had already become due to Metal Specialty from Atwood Vacuum under the contract up to September 24th, 1940. Rodgers v. Torrent, 111 Mich. 680, 70 N.W. 335; and second, that he is not entitled to maintain an action for damages for profits made after the date of the assignment.

This court having decided that certain of the hinges made by Atwood Vacuum came within the scope of the agreement, defendants' actions in refusing to recognize their obligations to divide the production was an abandonment of the arrange-

ment to divide the hinge production and that the assignment of September 24th, 1940, was in effect an acceptance of the abandonment of the arrangement to divide production, precluding Howe from collecting damages for failure to divide the production accruing after September 24th, 1940.

Seventh Question.

[22, 23] Reverting, in conclusion, to the question of the termination of this contract, we hold that royalties can be collected only up to the day of cancellation. As stated in Eskimo Pie Corp. v. National Ice Cream Co., D. C., 20 F.2d 1003, 1005 "plaintiff is entitled to an accounting, to determine what royalty, if any, had accrued under its license up to the date of its cancellation, and to recover such amount, and as to this claim the defendant is estopped to plead the invalidity of the patent. From the date of the cancellation of the license contract the defendant is to be treated as any other infringer, subject to the same liabilities and entitled to the same defenses as any other infringer, unless it be held that the agreement in the license not to contest the validity of the patent continues in force after the contract has by the conduct of the parties been terminated."

[24] Metal Specialty had the right to cancel the April 19th, 1939, contract in event of default by Atwood Vacuum by giving thirty days' notice. This court has held that the arrangement between Atwood Vacuum and Metal Specialty to divide the hinge business was terminated by the assignment of September 24th, 1940. It was acquiesced in by Howe by the acceptance by him of the assignment. It is the opinion of this court that under the facts in this case Atwood Vacuum would have the right, after September 24th, 1940, to cancel the licensing arrangement upon giving Howe thirty days' notice, under the law of mutuality of contracts. Wilkinson v. Heavenrich, 58 Mich. 574, 26 N.W. 139, 55 Am.Rep. 708.

[25] We therefore believe that plaintiff is entitled to recover for hinges made and sold by defendants up to a point thirty days after defendants' letter of March 21st, 1941. In other words, from then on plaintiff must seek any redress he may claim by infringement and he cannot here recover royalties on the license agreement after that day.

[26] We further believe that plaintiff is entitled to recover excess profits as defined in the April 19th, 1939, contract to September 24th, 1940, and 5 percent of the sales price, but not to exceed $4,000.00 on hinges sold by Atwood Vacuum prior to September 24th, 1940, as assignee of Metal Specialty, but that he cannot recover excess profits after September 24th, 1940.

An accounting between the parties will be made in accordance with this opinion and if unable to reach an agreement on the number and the amount the matter will be referred by this court to a master for the taking of testimony.

[27] Defendants' counterclaims for damages caused by the garnishment proceedings, brought simultaneously at institution of suit and for wrongful termination of the license contract between Metal Specialty Company and Atwood by the assignment of September 24th, 1940, are hereby dismissed—no damages having been shown.

An order in conformity with this opinion may be submitted to the court for its signature.

42 IN THE UNITED STATES DISTRICT COURT.

* * (Caption—54-C-1893) * *

N. D. Ill., E. D. Judge La Buy

167 F. Supp. 330 (1958) P.A. 51-62

FINDINGS OF FACT.

1. This is an action, with a jury demand, by Earl E. Howe, Plaintiff, against General Motors Corporation, Defendant, charging infringement by defendant of U. S. Letters Patent No. 2,201,490 for "Inclined Hinge", which issued May 21, 1940, and expired by its terms during the pendency of this action, which was filed December 17, 1954.

2. In response to a Motion for More Definite Statement, plaintiff specified that the defendant infringed the patent in suit by the use in automobiles of the hinging structure of the following automobile models:

Front doors—1953-54 Chevrolet
Front doors—1953-54 Pontiac
Rear doors—1950-51 Oldsmobile 98
Rear doors—1950 Buick, 40, 50 and 70
Rear doors—1951 Buick 50
Rear doors—1951-51 Cadillac 61
Front doors—1954-55 Oldsmobile

Front doors—1954-55 Buick 40 and 60
Rear doors—1955 Oldsmobile
Rear doors—1955 Buick 40 and 60
Front doors—1951-53 Oldsmobile Super 88
Front doors—1951-53 Buick 40
Front doors—1952-53 Oldsmobile 98
Front doors—1948-49 Oldsmobile 90
Front doors—1948-49 Cadillac 60, 61 and 62
Front doors—1949 Buick 50 and 70
Rear doors—1950-53 Buick 50 and 70
Rear doors—1950-53 Cadillac 60 and 62
Front doors—1954-55 Buick 50 and 70
43 Front doors—1954 Cadillac 60 and 62
Front doors—1955 Cadillar 62
Front doors—1955 Cadillac 60
Front doors—1948-49 Cadillac 75
Rear doors—1950-51 Cadillac 75
Front doors—1954-55 Cadillac 75
1948-1955 Chevrolet trucks
1948-1955 GMC trucks

3. The claims charged to be infringed with respect to each of such models as shown in blueprints filed by defendant are specified in Plaintiff's More Definite Statement.

4. The Howe patent in suit is directed to a gooseneck hinge of the pintle or hinge pin type for swingingly supporting a door of an automobile body from a curved body wall (that is, one with tumble-in), with a double inclination of the hinge axis to compensate for the tumble-in angle of the body so that the door can swing in a substantially horizontal arc. All of the claims of the Howe patent in suit are limited to a concealed hinge for supporting a door on a curved or inclined wall with the axis of the hinge pin having a double inclination so that the door in opening and closing swings through a substantially horizontal arc.

The patent discloses a unitary gooseneck hinge which supports the door, Figure 5 showing a double hinge having dual or separate hinge pins. Claims 3 and 4 are specifically limited to a gooseneck type of hinge. The gooseneck hinge disclosed in the Howe patent supports the door so that when the door is swung open is moves to a swing-out position; that is, in addition to swinging away from the body, it swings forwardly and provides much greater leg room for entrance to and exit from the body.

5. Upon motion of defendant, it was ordered on June 6, 1956 that the equitable defense of laches and estoppel asserted in Paragraph 10 of the Defendant's Answer be tried separately before the Court in advance of the jury trial of legal issues of validity and infringement. The trial of such equitable defense commenced before the Court on January 30, 1958 and was concluded on February 5, 1958. Since that time, both parties have filed briefs and proposed Findings of Fact and Conclusions of Law with the Court.

6. Earl E. Howe is now the owner of the patent in suit and of all rights thereunder, and he was the owner of the patent and such rights at the time this action was filed.

7. Plaintiff, Earl E. Howe, did not own the patent in suit and all of the rights thereunder during portions
44 of its term, including the period from the time of the issuance of the patent until final disposition of the suit between plaintiff and Atwood Vacuum Machine Company which occurred in 1953, and in the period between June 16, 1952 and October 6, 1954 when the patent in suit and all rights thereunder were owned by a joint venture, Howe Associates.

8. On March 16, 1938, Mr. Howe granted an option to The Metal Specialty Company, an Ohio corporation, to obtain an exclusive license under his patent rights, including those resulting in the patent in suit and an ex-

clusive license pursuant to the terms of such option agreement was executed on May 24, 1939, at which time the application for the patent in suit was pending in the United States Patent Office. The option and license to The Metal Specialty Company (Pl. Ex. 71) gave to the licensee the right to grant a sub-license and, on April 19, 1939, with Howe's consent, a license (Pl. Ex. 6) was granted to Atwood Vacuum Machine Company. This agreement in subsance divided the license rights from Howe between The Metal Specialty Company and Atwood Vacuum Machine Company. Subsequently, because of disputes between these two licensees, The Metal Specialty Company, on September 24, 1940 (Pl. Ex. 70) assigned to Mr. Howe all of its rights under the Atwood agreement (Pl. Ex. 6) and The Metal Specialty Company was released by Mr. Howe from its license agreement (Pl. Ex. 71). Atwood Vacuum Machine Company, however, continued as a licensee under the patent in suit, which had then issued, and a dispute arose between the Atwood Company and Mr. Howe relative to payment of royalties under the agreement. An action was filed by Mr. Howe against the Atwood Company for royalties and, after the suit was pending, the Atwood Company, on March 21, 1941, gave notice to Mr Howe that it no longer considered itself a licensee under the license agreement. The Howe v. Atwood action pending in the United States District Court at Detroit, Michigan was decided October 7, 1942 by The Hon. Frank A. Picard, United States District Judge, his Opinion thereon being published in 47 F. Supp. 979. In this Opinion and in the Judgment, it was held that the Atwood license was terminated thirty days after its letter of March 21, 1941, i.e., on April 20, 1941. After Judge Picard's Opinion of October 7, 1942, further steps relative to appeal or final disposition of the Howe v. Atwood case were carried on and the case was finally settled by the parties without an appeal or an accounting by an agreement of settlement.

9. Mr. Howe was not possessed of the entire right, title and interest in, to and under the patent in suit from a time prior to its issuance until some time in February, 1943 when the case of Howe v. Atwood was finally disposed of.

10. In February, 1943 and for some time prior thereto, World War II was in progress and General Motors
45 Corporation was not engaged in the production of passenger motor vehicles because of restrictions imposed by the Government, required by war purposes. While World War II terminated in August, 1945, General Motors Corporation did not resume the general production of automobiles until some time in 1946 because of a long strike of General Motors Corporation employees in the early part of 1946.

11. General Motors Corporation's first production of automobiles after the war did not involve new model automobiles until production commenced on the 1947 models.

12. On June 16, 1952, Mr. Howe entered into an agreement (Def. Ex. 99) with Ray W. Springer and the Detroit law firm of Toy and Toy, organizing a joint venture between them, one of the purposes of which was to obtain compensation for infringements of Howe patents, including the patent in suit. On June 16, 1952, Mr. Howe assigned the patent in suit and all rights of action thereunder to the joint venture (Def. Ex. 100). On October 6, 1954, the assignment to the joint venture was revoked and the joint venture agreement, including a license (Def. Ex. 101) to Howe Hinge Company was terminated by agreement between the parties thereto (Def. Ex. 102).

13. Earl E. Howe was not the owner of the patent in suit and of all the rights thereunder, including the rights to recover for infringement thereof, during the period commencing June 16, 1952 and ending October 6, 1954.

14. After October 6, 1954 when Earl E. Howe reacquired ownership of the patent in suit and of all rights thereunder,

preparations were made for the filing of the present action, which was filed on December 17, 1954.

15. The defense of laches and estoppel as set forth in Paragraph 10 of Defendant's Answer asserts that as a result of plaintiff's silence, acquiescence and lack of diligence during a period of more than fourteen years:

(1) Defendant has been led to believe that plaintiff has abandoned his charge of infringement and did not consider the hinged structures of defendant to violate any of his patent rights;

(2) Defendant has materially changed its position during said period;

(3) Defendant has been placed in a materially disadvantageous and prejudicial position because:

(a) Witnesses having knowledge of facts pertinent to defendant's defenses have died or otherwise become unavailable; and

46 (b) Documents and physical structures in support of said defenses have been destroyed, lost or misplaced.

16. The particular defense referred to in Paragraph 10 of the Answer which defendant contends has been affected by the delay in filing this action is the so-called "B. O. P. Defense" of prior invention by General Motors Corporation of the subject matter of the patent in suit.

17. During 1937 and 1938 and subsequently before the patent in suit issued, Earl E. Howe discussed automobile door hinges and hinging problems with a number of officers and employees of General Motors Corporation, making and demonstrating a number of models and drawings and even preparing and submitting full-size models for automobile door installations. The parties are in dispute as to the precise dates of many of these meetings, but there is no evidence that in these discussions in 1937 and 1938 General

Motors Corporation asserted to Mr. Howe that his developments in door hinging had been previously invented by General Motors Corporation or someone working for the defendant.

18. The application for the patent in suit was filed January 9, 1939 and it discloses door hinging means which are completely concealed from the exterior of the automobile when the doors are closed. All of the claims of the patent call for a concealed hinge "for supporting" or "adapted to support" a door.

19. The hinging means of the so-called "B. O. P. Defense" were first made available to the public by General Motors Corporation in the fall of 1938 upon the so-called 1939 automobile models. In such cars, the front doors were supported by two hinge portions, the lower one of such portions being concealed when the door was closed and the upper portion being exposed and protruding beyond the plane of the car body at that point.

20. On the 1939 B. O. P. automobile bodies, both the concealed hinge portion and the exposed hinge portion are required to support a door and no such 1939 automobiles were sold by defendant without both such hinging portions being used.

21. On June 21, 1940, one month after the patent in suit issued, plaintiff gave notice of infringement of the patent to General Motors Corporation. Subsequent notices of infringement were made on a number of occasions in 1940, 1941 and 1942. General Motors Corporation was fully aware of the Howe v. Atwood litigation. After Gen-
47 eral Motors Corporation resumed production of passenger automobiles following World War II, additional notices of infringement were given to it in 1947, 1949, 1951 and 1952.

22. The plaintiff was not silent in asserting to General Motors Corporation his charge that it was infringing the

patent in suit during the period prior to the filing of this action and there is no substantial evidence that defendant at any time was led to believe that plaintiff had abandoned his charge of infringement or that plaintiff did not consider concealed hinge structures of defendant to violate plaintiff's patent rights.

23. In 1949, General Motors Corporation did not consider that plaintiff had been silent or that he had abandoned his charge of infringement for it was recognized in their own records of September 2, 1949 (Pl. Ex. 88) that "Howe has been persistent" in asserting his claims. An officer of General Motors Corporation on September 20, 1949 wrote to Mr. Howe, again rejecting any settlement, but making no reference whatsoever to any charge of laches, neglect, silence or delay on the part of Mr. Howe (Def. Ex. 49-50).

24. In 1953 and 1954, General Motors Corporation advertised the 1954 Buick automobile, extolling the advantages of concelead swing-out hinges and the matter of the Howe patent was sufficiently in the mind of General Motors Corporation at that time that the Head of its Patent Section, Mr. Willits, had employees of the Patent Department of General Motors Corporation again look into the Howe hinge matter.

25. The fact is sustained by substantial evidence that General Motors Corporation was never lulled into any belief that the plaintiff had either abandoned his charge of infringement against General Motors Corporation or had reached a decision that the hinge structures of defendant did not violate his patent rights.

26. From the time the Howe patent issued in 1940, up to the present time, General Motors Corporation has taken the position that the Howe patent in suit is invalid and it has at all times continued to manufacture a series of changed and altered hinging means designed for each new model automobile which it has produced with a disregard

for the notices of infringement sent to it by Mr. Howe because of its stated belief that the Howe patent is invalid rather than because of any belief by General Motors Corporation that plaintiff either abandoned his charge of infringement or had decided that the hinge structures of defendant did not infringe his patent rights.

48 27. Each year that General Motors Corporation has changed to a new model of an automobile to be offered for sale to the public, the design of hinging means for the doors of such models has been a new and independent undertaking since it is stated by General Motors Corporation that replacement hinges must be made for each model automobile even though the hinge elements may appear to be closely similar.

28. The delay of plaintiff in filing an action charging infringement by a 1949 automobile model is a different and separate delay from a charge of infringement or action for infringement against a subsequent automobile model made by General Motors Corporation, such as a 1953 or 1954 model.

29. Defendant asserts that it has expended large sums of money for tooling, dies and the like for the several hinging means which are charged to infringe and defendant asserts that the expenditures for such tools have resulted in a material change of its position during the period since the first hinging means charged to infringe were made. However, it appears clearly from the record that tooling costs of General Motors Corporation are amortized completely by it during the sale of each specific model automobile and that such costs have been completely amortized at the time the manufacture and sale of automobiles by General Motors Corporation has been diverted to a new model. Since the cost of tooling has been amortized and charged off against income as to every automobile car model charged to infringe in this action, such tooling costs do

not represent a matter of change of position or of prejudice to the defendant resulting in any inequity in maintaining the present action.

30. The defendant contends that by the lapse of time, documents and models have been lost, witnesses have died or become unavailable and witnesses' memories have become dimmed or confused. It has not been shown by the defendant that any dead or unavailable witnesses are necessary or essential and that their absence is materially prejudicial to the defense.

31. The fact that General Motors Corporation did participate in the Howe v. Atwood case establishes that during that litigation it was in no way misled into a belief that Howe was acquiescing in any infringement by General Motors Corporation which occurred prior to the war. There is no evidence to show that anything that Howe ever did or did not do lulled General Motors Corporation into a belief that it had a right to use the inventions described and claimed in the Howe patent in suit without liability therefor.

49 32. Because Howe had already charged and was charging defendant with infringement during the period from 1940-1942, defendant looked into and followed the Howe v. Atwood case brought by Howe in 1941 in Detroit, Michigan, against Atwood for royalties due under an agreement wherein Atwood was licensed under the Howe patent. Only hinges made by Atwood and none of defendant's hinges were covered by the license agreement. Defendant, at the request of Atwood and his attorneys, supplied some information, made suggestions and furnished some evidence, but the decision to use or not to use such information, suggestions and evidence was solely that of Atwood and his attorneys, Meder, Larwin and Wintercorn, who were under no compulsion whatsoever from defendant. Defendant was not a party to the suit or in privity with

Atwood, did not contribute to the defense of the suit, had no financial interest in the outcome of the litigation, had no legal right to defend or appeal from the decree and did not control or participate in the control of the defense of that suit. The decision to settle the case and not to appeal was Atwood's sole decision. Defendant, therefore, is not estopped by the Howe *vs.* Atwood decree of Judge Picard in favor of Howe from relying herein on its 1939 BOP defense of prior invention nor is defendant guilty of any unclean hands or of any misconduct by reason of its assistance to Attood in Howe *vs.* Atwood and its following of that suit.

33. Material in evidence from General Motors' files and records show that General Motors recognized the likelihood of a suit by Howe and of the importance of collecting and preserving evidence; that General Motors had been repeatedly warned by its own counsel of the likelihood of a suit; that General Motors continued its infringement because of its belief that the Howe patent would not be sustained, rather than that Howe had abandoned his claim as now asserted.

34. General Motors has not shown that it has any investment which would be jeopardized by a trial of this case.

50 Conclusions of Law.

1. The facts of record do not establish that defendant has been led to believe that plaintiff has ever abandoned his charge of infringement or that he has not considered the accused hinging means sold by defendant to infringe the patent in suit.

2. The facts of record do not establish that defendant has changed its position in any material manner such as would make it inequitable for plaintiff to prosecute this action for infringement.

3. The facts of record do not establish that delay in filing action has resulted in the loss of any material or necessary evidence, or in the death or unavailability of any necessary or essential witness.

4. The present action is based upon new and different acts of infringement by defendant which have occurred in the six years prior to the filing of this action and not before. There is no evidence which shows that such acts were committed by defendant in reliance upon any silence or acquiescence of the plaintiff and the mere lapse of time which has occurred between the commission of such acts and the filing of this action does not constitute laches.

5. The facts of record do not establish that General Motors Corporation in reliance upon acts or silence by plaintiff upon which General Motors Corporation had a reasonable right to rely was led to change its position in any way such as to create an equitable estoppel which would prevent the plaintiff from prosecuting this action.

6. Mere delay does not establish laches and the burden of sustaining the defense of laches and estoppel rests upon the party asserting such a defense. The defendant has not sustained this burden.

7. This cause shall proceed to trial on the merits of the charge of patent infringement at a date to be fixed by the Court.

Walter J. LaBuy,
United States District Judge.

Dated: October 17, 1958.

UNREPORTED * D. A. III 2156 - 2160

1 IN THE UNITED STATES DISTRICT COURT.

* * (Caption—54-C-1893) * *

TRANSCRIPT OF PROCEEDINGS had in the above entitled case before the Hon. J. Sam Perry, one of the judges of said court, in his courtroom in the United States Court House, Chicago, Illinois, on September 29, 1961.

Present:

Mr. Warren C. Horton, Mr. Marshall Sutker, appeared on behalf of plaintiff;

Mr. George N. Hibben, appeared on behalf of defendant.

By the Clerk: 54 C 1893, Howe *vs.* General Motors. Motion for an order setting aside this court's order of September 20, 1961, granting a new trial, and for further order granting a rehearing on plaintiff's motion for new trial. There is also a motion for judgment in accordance with defendant's motion for directed verdict filed on April 6, 1961.

2

Mr. Hibben: If the court please, I called Mr. Horton during the lunch hour. We just received notice of this order this morning from the clerk's office, the order being entered on the 20th of September, and we have ten days under Rule 50 in our opinion within which to file one of these motions. Consequently we went in before Judge Miner at 2:00 o'clock, to whom this case had been reassigned by the executive committee, and he stated that he was not in a position to rule on these motions and he therefore transferred this back to this court for the purposes of these post-trial motions.

We are asking at this time that this court hear these motions. We would like to file briefs and be heard on the motions.

Mr. Horton: If your Honor please, the motion for directed verdict which is now presented, was of course
3 —there was a motion for directed verdict presented during the course of the trial and at the close of all evidence. Then there was a verdict by the jury which disposed I think of the motion for a directed verdict, since it was in favor of the party making the motion.

Then there was a motion for new trial, and the motion for new trial of course is directed to the discretion of the court and that was granted.

I do not think, as I understand it, that there can be a motion for directed verdict which would stand in the face of the order for a new trial. I think that would be moot, and it therefore seems to me that the only proper motion is whether or not there is to be reconsideration of our motion for new trial.

Mr. Hibben: If the court please, I would like to be heard in brief on that point as to that motion, but I would like to call the attention of the court to a similar situation in a patent case that came up out of New Orleans where there was a jury verdict in favor of the defendant, it went up to the Court of Appeals, the Court of Ap-
4 peals reversed and sent it back down for new trial, but in its opinion the Court of Appeals stated that perhaps the defendant could then bring up its motion for directed verdict, which it did do, and that was under Rule 50, and we have a similar situation here.

We believe that this motion for a judgment in accordance with the motion for directed verdict is perfectly proper.

The Court: Well, offhand it would seem to me that the motion for directed verdict, we would have had a hearing on that had the matter been brought up. However, it seems to me to have become moot. You have that very relief which you asked for. You asked for a directed ver-

dict and the jury gave you that verdict. So the jury superseded any order of mine.

Mr. Hibben: That motion was directed to the attention of the court and not to the jury, and it would be based upon matters of law that would not be for the jury, and that was the purpose of that motion, and it has never been ruled upon, nor was it ruled upon in the case of Thurber *vs.* Fairchild and Ford Motor Company in the eighth circuit, but the district court did hear, and after reversal the defendants in that case did get the verdict.

5

I certainly would like to—

The Court: Your theory was that the plaintiff did not make a case. That was the theory of your motion for a directed verdict, wasn't it?

Mr. Hibben: That would be part of it, that—

The Court: That they did not legally make a case.

Mr. Hibben: Yes, that would be part of it, but we would be entitled as a matter of law—

The Court: That is the substantial—

Mr. Hibben: Well, it is more than that.

The Court: That is what I mean, as a matter of law, that is the heart of your—

Mr. Hibben: As a matter of law, aside from the facts. I would like to brief this point, if the court please, and show the court decisions on that point. I believe that Thurber *vs.* Fairchild—

The Court: Well, I spent a lot of time on it. It would seem to me that everything should have been covered in the briefs on the motions that were made to set aside the jury verdict. I can't change the law, but I will say this, that the complicated issues of that case and similar cases, going to a jury, I cannot understand that as being a case for a jury. The jury was so completely confused in that matter, even the foreman of the jury wrote me and said, "We just didn't know what it was all about."

6

Mr. Hibben: Well, if the court please, patent cases are primarily for a judge—

The Court: That is right.

Mr. Hibben: And we had no—

The Court: Of course, that case was not for a jury.

Mr. Hibben: We had no choice in this case. Plaintiff asked for the jury—

The Court: I know it, I know it.

Mr. Hibben: —and we did the best we could.

The Court: I know plaintiff asked for the jury, but it is no case for—

Well, I will be perfectly frank with you, had it been a non-jury case I would have found the patent good and would have found infringement, and that is really the heart of why I granted a new trial, because I think it is my
7 duty to give my best opinion as to what justice should ultimately be, and I thought that it was a valid patent and I thought it was infringed, and I also thought that the tremendous amount, tremendous amount, of demonstrative evidence that was presented by the defendant, the innumerable doors that were brought in, the excessive amount of evidence, did unduly influence the jury in the matter.

I do not think I wish to go into it any further, gentlemen. I believe that the order should stand as it is. If I am wrong in refusing to consider a motion to direct a verdict after a jury has rendered a verdict, there is an adequate appeal from that. But I spent over a month in trying that case, I spent hours and hours on the briefs in this matter, and I think I shall deny the motions and leave the record as it is. That is my honest opinion about it.

Mr. Hibben: May I ask the court, the remarks of the court then that have been given today are the grounds for the granting of the motion for a new trial?

The Court: Those are not full and in detail, but
8 you are perfectly at liberty to have my statement written up as some of the things I had in mind when I considered this case. If I ever saw a good patent that was it. That was my honest opinion of the matter. If there had been too much of a serious doubt I would not have granted a new trial by a jury. That is also the reason why I sent it to another judge, that I felt I already had my mind made up and if it should be tried that a judge who had not already formulated an opinion should hear it. I thought I owed that to you and your client to let a judge who had not made up his mind on it handle it, and I studied this record and I made notes on the matter, and that is my honest opinion.

I don't like to render all the decisions in favor of this gentleman here, but—

Mr. Horton: You haven't all, your Honor.

The Court: —but I had to render two right straight along here—

Mr. Horton: It was nice that they came so close together.

Mr. Hibben: If the court please, we have never really had a ruling on that motion for directed verdict, and
9 on the motion for new trial we did not have an opportunity to go into the merits. I directed my remarks to the matter of certain points in evidence and to the instructions, but we never did review the case before your Honor on the merits as a matter of law and anticipation by the prior art patents.

I would like an opportunity to be heard on that, because it has been way back since last March and April that this was before the jury and this court.

Mr. Horton: If your Honor will recall, there were proposed instructions to the jury which were in the court with the motion for a directed verdict, and which directed verdict motion called for a directed verdict for the defendant. Those were argued.

Mr. Hibben: Though not on the merits.

The Court: I recognize I could set down a hearing for that, and if I still decided as I do that the whole question would be moot, I recognize the possibility that you would have a right of appeal on it, that there is a legal point there maybe, but I am firmly convinced that after hearing all of the facts and all of the law on it, that had it been brought to my attention I would have refused to grant your motion for a directed verdict, and so I don't wish to prejudice your right to appeal that point. Therefore, I do not wish to rule on that point any further. I think the jury's verdict has sufficiently cured it. It may be that I am in error, and if so the court above can tell me, but you know my position on it.

I don't believe that I wish to go into the case any further. It was my best judgment, and I told you my opinion as to the law and as to the facts is that there was a good patent, and that it was infringed.

You can know why my decision would be—unless there is something revolutionary, if I spent more time on it, and after spending five weeks in trial on it and then weeks going over the briefs, and so on, hours and hours, I believe another judge should take a fresh look at it.

Motion denied. I think we will leave it as it is.

265 IN THE UNITED STATES DISTRICT COURT.
* * (Caption—54-C-1893) * *
N. D. Ill., E. D. Judge Robsán
252 F. Supp. 924 (April 5,1966); P.A. 708 - 737

DECISION ON THE MERITS.

History of Litigation.

This suit, filed December 17, 1954, concerning the validity and infringement of the Howe Patent No. 2,201,490, on an "Inclined Hinge," is now before the court for decision on the merits, after trial by the court. A long and tortuous background preceded this decision.

The first adjudication was that of Judge Walter J. La Buy, who in October, 1958, after hearing evidence, overruled the defense of laches and estoppel (*Howe* v. *General Motors Corporation,* 167 F. Supp. 330 (N. D. Ill. 1958). Subsequently, there was a jury trial in June, 1960, before Judge La Buy, which ended in a hung jury. Judge La Buy denied defendant's motion for a directed verdict without stating his reasons for the denial.

266 A second jury trial in April, 1961, before Judge J. Sam Perry, resulted in finding the defendant not guilty. Judge Perry vacated and set aside this finding and ordered a new trial. Following this ruling the Court of Appeals denied a petition for a writ of mandamus, or, in the alternative, for a writ of certiorari, finding no abuse of discretion in the denying of defendant's motion for a directed verdict, which motion had been taken under advisement during the course of the trial (*General Motors Corporation* v. *Perry,* 303 F. 2d 544 (7th Cir. 1962)). There had also been a suit, in another district, upon a license granted by Howe at the time the application for this patent was pending, upon which license litigation ensued with an opinion in favor of patentee (*Howe* v. *Atwood,* 47 F. Supp. 979

(E. D. Mich. 1942)), and which litigation ended in a settlement without appeal.

The observations of the various judges who have had occasion to comment upon the Howe patent are interesting. In the royalty suit between Howe and licensee Atwood (*Howe* v. *Atwood*, 47 F. Supp. 979 (E. D. Mich. 1942)), the court said, at 986:

> "* * * [I]t is the understanding of this court that the secret of the claims of the second hinge [Patent '490] lies in the fact that the inclination of the axis inwardly from the car door and longitudinally towards the front of the car is accomplished by the use of an inclined pintle built into the hinge, this inclination being compensated for by using a gooseneck hinge member varying the extent of its curvature from top to bottom."

267 The Court goes on, at 987:

> "* * * [T]he drawing accompanying the second Howe hinge shows how it could be utilized with two pintles as well as one, and incidentally one of the arguments used by defendants in limiting Howe's first patent was that his drawings did not cover a duplex (two pintle) hinge. But Howe's drawing in the second patent did—and the drawings accompanying a patent with its claims are illuminating when the question of prior art and intended coverage is at issue."

Judge La Buy in *Howe* v. *General Motors Corporation*, 167 F. Supp. 330 (N. D. Ill. 1958), stated, at 331:

> "* * * [The patent] is directed to a gooseneck hinge of the pintle or hinge pin type for swingingly supporting a door of an automobile body from a curved body wall (that is, one with tumble-in), with a double inclination of the hinge axis to compensate for the tumble-in angle of the body so that the door can swing in a substantially horizontal arc. All of the claims of the Howe patent in suit are limited to a concealed hinge for supporting a door on a curved or inclined

wall with the axis of the hinge pin having a double inclination so that the door in opening and closing swings through a substantially horizontal arc. The patent discloses a unitary gooseneck hinge which supports the door. . . . The gooseneck hinge disclosed in the Howe patent supports the door so that when the door is swung open it moves to a swing-out position; that is, in addition to swinging away from the body, it swings forwardly and provides much greater leg room for entrance to and exit from the body."

Judge Perry in a statement made on September 29, 1961, on a motion for an order setting aside the order of September 20, 1961, granting a new trial, said:

"• • • I will be perfectly frank with you, had it been a non-jury case *I would have found the patent good and would have found infringement,* and that is really the heart of why I granted a new trial, because I think it is my duty to give my best opinion as to what justice should ultimately be, and I thought that it was a valid patent and I thought it was infringed, and I also thought that the tremendous amount of demonstrative evidence that was presented by the defendant, the innumerable doors that were brought in, the excessive
268 amount of evidence, did unduly influence the jury in the matter. . . . That is my honest opinion about it. . . . If I ever saw a good patent that was it. If there had been too much of a serious doubt I would not have granted a new trial by a jury. . . . It was my best judgment, and I told you my opinion as to the law and as to the facts is that there was a good patent, and that it was infringed." (Italics added.)

Decision.

This court after a careful examination of the prior proceedings reaches the unescapable conclusion that the patent is invalid because anticipated by the prior art and as one which should have been obvious to a skilled worker in that field in view of that prior art.

Patent and Pleadings.

Patent No. 2,201,490, consisting of four claims, issued May 21, 1940, upon an application filed January 9, 1939, expired May 21, 1957. Written notice of infringement was given defendant on July 10, 1942. Infringement is charged for the period from December 17, 1948, to date of the patent's expiration in 1957.

The complaint and supplement thereto charge infringement by defendant "by making and/or selling automobiles wherein the front doors of the bodies thereof are supported by concealed hinging means of the gooseneck type as covered by said Patent No. 2,201,490," and allege the damages for infringement to exceed a million dollars, and seek treble damages. An amendment to the complaint and supplemental complaint filed July 18, 1963, asked for an accounting of the damages and withdrew the demand for a jury trial.

269 The answer denied infringement and asserted invalidity of the patent on the ground that the invention was disclosed in prior art patents and publications, and the alleged invention had been known and reduced to practice by General Motors more than two years prior to the disclosure in the application for the Howe patent. Further, defendant asserts lack of invention; Howe's disclosure involving mere mechanical skill; the claims of the patent are vague, and they are broader than the scope of the original application and are not supported by supplemental oath of the applicant.

Howe stated in his patent that "[t]his invention relates to a concealed door hinge particularly adapted for swingably supporting a door from a curved wall, as for example, the support of an entrance door of an automobile which is curved in direction normal to swinging movements and further, in conjunction with walls which are inclined as in

the case of an automobile body having upwardly converging side walls."

The highlight of plaintiff's invention would seem to be the fact that the hinge is *completely concealed* within the body of the car thereby maintaining the trimness of body line and protection of the hinge from the elements. This is achieved on a car, the contour of which is *inwardly* inclined by having the axis of the hinge also inclined inwardly, and generally forwardly, with the result that when the door is opened it swings *in a substantially horizontal arc.* This prevents sudden closure of the car door due to force of gravity on a passenger entering or alighting.

270 Stipulated Facts.

The stipulation of facts filed December 30, 1963, presents these facts: Plaintiff, Earl E. Howe, is the owner of all rights under the patent in suit. An exclusive licensee, The Metal Specialty Company of Ohio, had granted a sublicense to the Atwood Vacuum Machine Company but the Metal Specialty Company assigned its rights back to Howe, who, when a dispute arose, sued the Atwood Vacuum Machine Company and had an opinion in his favor. Defendant was not a party to the Atwood litigation, but followed it. It had no control over it although it furnished some evidence therefor.

Each of defendant's hinges charged to infringe includes an upper hinge element and a lower hinge element. The claims which they allegedly infringe are stated.[1]

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1. Nos. 12 (12-U & 12-L), 14 (14-U & 12-L), 18 (18-U & 18-L), 26 (12-U & 12-L), and 36 (12-U & 12-L), charged to infringe Claims 1 and 2.

Nos. 19 (19-U & 19-L), 33 (33-U & 33-L), 29 (27-U & 31-L), 31 (27-U & 31-L), 40 (40-U & 41-L), and 42 (42-U & 42-L), charged to infringe Claims 1, 2, 3 and 4.

Nos. 27 (27-U & 27-L), 37 (27-U & 27-L), B (302-U & 302-L), G (307-U & 302-L), I (309-U & 302-L), and L (312-U & 312-L), are all charged to infringe Claim 4.

The stipulation of facts also sets forth the precise automobile, year, make and series, which infringes each of the claims, and further gives the exact inclination of the hinge axis, all of which are inclined inwardly, and some of them are specified to be also inclined forwardly or rear-
271 wardly. It is also stated whether the hinge occurs on the front or rear doors. The exact angle of inclination is given in each instance.

The prior art patents on which defendant relies are:

Richard, No. 1,325,109 issued December 16, 1919 (concealed hinge but pin vertical).

Smith, No. 2,050,469 issued August 11, 1936 (not concealed but no pins).

Carr, No. 2,114,830 issued April 19, 1938 (means not concealed on inside).

Soss, No. 1,363,370 issued December 28, 1920 (not limited to autos and inclined walls).

French patent (Mouche), No. 537,011 issued in 1922.

A publication by von J. Feldwabel, published in Germany in 1920, and other publications are also relied on as prior art.

Discussion of Prior Art and Contentions in Respect Thereto.

I. Mouche Patent.

As to the prior art, the French Mouche Patent No. 537,011 was applied for June 4, 1921, and granted February 23, 1922. Mouche states (as revealed by the translation):

> "The present invention has for object a hinge device applicable especially to doors, the profile of which vertically affects a more or less pronounced curvature which corresponds exactly to the profile of the wall having the door, such as, for example, the doors or carriage doors of automobiles, horse-drawn vehicles, cars, etc.

> "By its disposition this system compels the door on which it is mounted to expand during the opening and closing while preserving a constantly vertical position. Furthermore, this hinge takes up no external space being lodged in the thickness of the panels of the partition and of the door on which it is mounted."

272 Plaintiff reads this foreign patent in the light of the legal principle that "[t]he law is very well established that 'a foreign patent is to be measured as anticipatory, not by what might have been made out of it, but by what is clearly and definitely expressed in it.' *Borg-Warner Corp. v. Mall Tool Co.*, 220 F. 2d 803, 805."

Plaintiff points out that the Mouche patent called for an *outward and rearward* inclination of the axis, and pertained to a *tumble-out* body. The upper hinge is smaller in curvature than the lower hinge. Mouche showed a wooden door and described pintles out of alignment, and stressed the vertical position of the axis. There was no glass in the Mouche door. Carl E. Hedeen, General Director of Engineering of the Fisher Body Division of General Motors Corporation, testified that the Mouche drawing shows a compound angularity of the hinge is required. No vehicle was built with the Mouche hinge. Plaintiff asserts that the Mouche patent discloses an inoperative structure, and Mouche did not recognize or solve the problem covered by the Howe patent.

On the other hand, defendant argues that the Mouche patent discloses "all of the features of the Howe patent," being similar in structure, mode of operation and result, with the same problem and the same result. Further, if Mouche is to be held inoperative because the door does not open to a full 90° so must Howe be held inoperative. The Mouche patent, although a foreign patent, is applicable because its disclosure is clearly expressed to a man skilled in the art.

273 **II. The Carr Patent.**

The Carr Patent No. 2,114,830, applied for January 15, 1935, and issued April 19, 1938, pertained to "an improved vehicle body of the convertible type which is streamlined both when the top and windows are raised and when both the top and windows are lowered. . . ." Plaintiff differentiates the Carr patent in that Carr's hinging means are "concealed" but only in the sense that they are covered or screened from view by *additional structure.* They are not *within* the contour of the body. The hinging means near the top of the door extends to a substantial extent inside the body, as does the lower hinge means. *The hinge is not inclined* in any manner as described by Howe. The Carr hinge is at the *rear* of the door, and if at the front edge, both top and bottom of the hinge means would be outside the body contour.

Mr. Hedeen stated that Carr showed a tumble-in body and describes a concealed hinge of gooseneck variety and inclination of axis rearwardly, and inwardly or outwardly, and glass in the doors. On cross-examination, he stated he never knew a car built like that shown in the Carr patent, which covered a single door hinged at the rear.

Defendant points out that Carr teaches that the hinge axis may be inclined inwardly as well as rearwardly which is the same as the compensating hinge axis inclination on the rear door in Figure 1 of the Howe patent. Carr's upper gooseneck hinge is of greater extent at the top than at the bottom so as to be of tapered shape like Howe.

274 **III. The Richard Patent.**

Plaintiff distinguishes the Richard Patent No. 1,325,109, which issued December 16, 1919, on an application filed March 10, 1919, for a "Hinge Construction" as disclosing a hinge for a touring car and not a car with an *inclined*

body. The axis of the pintles is vertical and there is no inclination whatsoever either described or shown. The hinge arms at the top and bottom of the door have the *same* reach. The hinge is *exposed* on the inside of the body. No car was ever made using the Richard hinge. Mr. Hedeen testified that since the wall or door edge was vertical in Richard and the hinge axis vertical, constant sized hinges could be used. The drawing discloses a curved body but not one inclined inwardly from the base up, rather a symmetrical curvature so that the axes of the hinges are in vertical alignment.

Defendant states that "Richard's body styling did not require an inclined axis" but that the problem he solved was to provide *concealed* hinging which would throw a curved door out away from the body at top and bottom, and Howe's hinge does so in a similar manner.

IV. 1917 Chevrolet.

The 1917 Chevrolet, cited as anticipatory, had *concealed* hinges, Mr. Hedeen testified. The door axis was inclined *outwardly*, with the result the door fell on opening, in the neighborhood of an inch, which he considered to be a substantially horizontal arc. Mr. Hedeen admitted the 1917 Chevrolet door was light weight, with axis inclined outwardly, not forwardly or rearwardly, and had a *tumble-*
275 *out* side. This 1917 Chevrolet, defendant maintains had its front doors supported by means of separate, spaced, concealed hinges of the U-shaped, gooseneck type secured to the edge of the door and which permitted the doors to swing in a horizontal arc.

V. The 1924 Oakland.

Plaintiff dispels anticipation by the defendant's 1924 Oakland car because *outside exposed hinges* were found to be necessary when using a full-sized door on a closed automobile body. Its body was built on a wooden frame and it was *straight and boxy.*

Mr. Hedeen testified it was a unitary type of hinging, gooseneck, concealed from both the inside and outside of the body, which was a tumble-out body and the hinge axis inclined outwardly and forwardly. On cross-examination, Mr. Hedeen stated the 1924 Oakland ~~doors~~ were *light* doors with three outdoor hinges all *exposed.* He also stated ~~the~~ type of hinge could not be used on modern automobiles because perfectly vertical pillars are not used.

Defendant relies on the fact the 1924-1925 Oakland hinge had "additive hinge inclinations" with the same structure, mode of operation and result as defendant's, and therefore if defendant infringes, the Oakland hinge anticipates and invalidates Howe (*Miller* v. *Eagle Manufacturing Co.*, 151 U. S. 186, 200 (1894)).

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that such exposed

VI. The Soss Patent.

The Soss patent, applied for June 17, 1920, and issued December 28, 1920, was for a "hinge." It disclosed 276 gooseneck hinges but made no reference to automobiles.

When it was applied for in 1920, closed automobiles were not in production except those which were custom made. Plaintiff points out there was no angularity in the disposition of the axis and there was no divergence between the top reach and the lower reach even if two hinges were used.

Defendant insists that its hinge is quite similar to the Soss hinge and therefore follows the prior art.

VII. The Feldwabel Publication.

The 1920 Feldwabel publication pertained to a "Door Installation on a Touring Car with Concealed Hinges." Plaintiff distinguishes this publication by pointing out that Feldwabel found it necessary to provide an *outside exposed hinge* for all car models except the light weight half-doors or gates to be used on carriages or touring cars. There was a fully exposed pintle. Plaintiff also points out that Feldwabel refers to hinging on the half-doors, expressly stating that the hinges will not be the same as on full doors. Mr. Hedeen testified that the Feldwabel door was a very light, narrow door with no glass in it. The hinge axis in Feldwabel inclined outwardly.

Defendant maintains that Feldwabel's structure is substantially the same as Howe's and the mode of operation and the result are the same. They have the same "cone effect." Feldwabel discloses two spaced, concealed, gooseneck hinges for supporting a door from a curved body pillar in an automobile body having an outwardly inclined wall;

an outwardly inclined hinge pin axis which would cause
277 the door to drop as it is opened; a rearwardly in-

clined hinge pin axis which would cause the door to rise and which therefore compensates for and subtracts from the outward inclination so that the door swings in a substantially horizontal arc. He also stated the hinge axis is inclined with respect to the adjacent edge of the door; gravity biases movement of the door toward a closed position; the hinge arms are of different lengths, the lower hinge arm being of a greater length than the upper hinge arm and each hinge arm being tapered from top to bottom. He also testified that in open position the gooseneck hinges hold the door away from the curved body, the lower or longer hinge holding the door further away from the body.

Mr. Hedeen in effect testified that Feldwabel disclosed

Howe's principle in reverse, the auto body being curved outwardly. Hedeen further testified there was no difference in technique between hinging of touring cars and open roadsters and the accused sedans. He stated that the only difference in having glass is the requirement of stronger hinges.

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VIII. 35 XP 510 Drawing.

The drawing 35 XP 510, dated September 23, 1935, which was as to an experimental structure evolved by experts at General Motors, showed the axis was inclined inwardly of the car body at the top hinge and outwardly of the car body at the lower hinge, with the top hinge *exposed inside* the body and the lower hinge *exposed outside* the body.
278 It was experimental and abandoned. It was never used and never went into production, Mr. Hedeen testified. He also testified the drawing showed a concealed hinge, which a model demonstrated to be a compensating hinge axis. The hinge was inclosed on the inside under the instrument panel, but the lower hinge was exposed. He said all of Howe's disclosures were found in the *upper* hinge of 35 XP 510.

Defendant maintains that 35 XP 510 was not purely experimental, but in fact was the forerunner of the commercial 1939 B. O. P. The September 23, 1935, date of 35 XP 510 is prior to plaintiff's earliest date of conception of June 7, 1937, and therefore supports defendant's defense of prior invention under 35 U. S. C. 102(g), and it is not necessary that the disclosure have been made public. Nor, defendant contends, did plaintiff prove a reduction to practice prior to his filing date, and a completed act of invention requires a reduction to practice by building and successfully testing the hinging after conception (*Automatic Weighing Machine Co.* v. *Pneumatic Scale Corporation*, 166 Fed. 288 (1909)).

IX. The 1939 "B. O. P." Defense.

The 1939 "B. O. P." (abbreviation for Buick, Oldsmobile and Pontiac for 1939) hinging means is claimed by defendant to anticipate or invalidate the patent in suit. These means were developed by General Motors' engineers and were manufactured early in 1938 by the Ternstedt Division and were first installed in the 1939 model in the spring of 1938 and the test bodies were shipped by Fisher Body 279 commencing in March, 1938, to Buick, Oldsmobile, Pontiac and Cadillac Divisions of General Motors for assembly into 1939 B. O. P. test cars. A test car was driven at the Milford proving grounds in July, 1938. Defendant's 1939 year model cars were first disclosed and sold to the public some time in September, 1938.

The stipulation, in addition to the above, states:

> "The '1939 BOP' models had front-door hinging means including an upper concealed hinge element and a lower hinge element which was not concealed, but extended beyond the contour of the body of such automobile models. The hinge axis on '1939 BOP' models extended between the upper concealed hinge portion and the lower unconcealed hinge portion and a portion of said hinge axis line extended outside of the body contour in such models."

As to the 1939 B. O. P. anticipation of the patent, defendant asserts the Howe patent claims are broadly worded to "a concealed hinge" and not hinge "means" and they do not require that the concealed hinge be the sole support for the door. The patent nowhere refers to a hinge means but only a "concealed hinge." Plaintiff by so construing is reading limitations into a broad claim in order to save it from anticipation, which has been condemned by the courts (*McCarty* v. *Lehigh Valley Railroad Co.*, 160 U. S. 110 (1895); *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147 (1950): *Enterprise Railway Equipment Co.* v. *Pullman*

Standard Car Mfg. Co., 95 F. 2d 17 (7th Cir. 1938); *Permutit Co.* v. *Graver Corporation*, 43 F. 2d 898 (1930)).

Mr. Hedeen testified that the 1939 B. O. P. showed forward and inward inclination of hinge axis with goose-
280 neck hinges, with the upper hinge concealed and the lower hinge exposed, and with a "certain amount" of tumble-in condition.

Defendant states that the 1939 upper hinge is a "concealed hinge for supporting a door" as described in Claim 1 of Howe, even though it may not be the sole support. The 1939 upper concealed hinge is located at the same place as Howe's hinge. Further, Howe, by letter of July 10, 1942, charged infringement of his patent by that upper 1939 hinge.

Defendant points out that a patentee may not in one suit achieve a pronouncement of broad validity of his patent and in a subsequent suit seek to avoid anticipation by narrowing the scope (*Smith* v. *Hall*, 301 U. S. 216 (1937)).

The 1939 B. O. P. structure of General Motors, plaintiff claims, is simply an example of the type of outside exposed hinging which Smith described as typical and inadequate and presented the problem which patentee solved, and to which defendant turned after a year and a half of use of the 1939 B. O. P. structure.

The breadth of plaintiff's step of invention is supported, he maintains, by the fact that even the fashioning of the 1939 B. O. P. partially exposed, partially concealed, hinges took the skill of many hundreds of engineers several years to achieve, and was quickly abandoned in 1940 when Howe's invention became known.

The 1939 B. O. P. rear door hinging, plaintiff points out, was disclaimed early in this suit in the proceeding be-
281 fore Judge La Buy, as having anything to do with the Howe '490 patent. In any event, the 1939 B. O. P. rear door hinging was quite unsatisfactory, too weak, and

sagged. The upper portion of the hinge alone could not support the door. It had no double inclination, and its inclination inwardly was of but two degrees. It had no divergence between the top of the hinge and the bottom of the hinge with different reach at the top than at the bottom. No 1939 car was sold without both hinges, Judge La Buy found. The 1939 B. O. P. structure was abandoned by General Motors, and is not charged to infringe. Cessation of use of the 1939 B. O. P. hinges was due to changes in body styling, defendant points out.

The 1939 B. O. P. structures do not meet the terms of the Howe patent, plaintiff insists, because not only are they exposed hinge means, but the hinging comprises an upper gooseneck type hinge and a lower butt hinge, exposed beyond the contour of the body.

Plaintiff contends that the 1939 B. O. P. prior *knowledge* defense is inutile because, being presented under 35 U. S. C. § 102(a), plaintiff could not have had the requisite knowledge of the conception of the 1939 B. O. P. structure, it having been kept secret until its disclosure to the public on the sale of the 1939 model cars in the late fall of 1938, which was after Howe's disclosure (*Gayler* v. *Wilder*, 10 How. 477; *Rem-Cru Titanium, Inc.* v. *Watson*, 152 F. Supp. 282 (D. D. C. 1957)).

In discussing the B. O. P. defense, Judge La Buy stated, at 333-334 (167 F. Supp. 330):

282 "The hinging means of the so-called 'B. O. P. Defense' were first made available to the public by General Motors Corporation in the fall of 1938 upon the so-called 1939 automobile models. In such cars, the front doors were supported by two hinge portions, the lower one of such portions being concealed when the door was closed and the upper portion being exposed and protruding beyond the plane of the car body at that point.

"On the 1939 B. O. P. automobile bodies, both the

concealed hinge portion and the exposed hinge portion are required to support a door and no such 1939 automobiles were sold by defendant without both such hinging portions being used."

X. The Smith Patent.

The Smith Patent No. 2,050,469, plaintiff points out, discloses the *problem* solved by Howe. It states:

> "It is common practice to use hinges of the pintle type in mounting the doors on vehicle bodies, but such hinges require the pintles to be in alignment, and on the modern vehicle bodies that usually means one or more of the hinges *must extend laterally outward* beyond the surface of the body to such an extent as to afford considerable air resistance to the rapid transit of the vehicle." (Italics supplied.)

Smith, plaintiff claims, could see no way to use a pintle hinge on such structures and have fully concealed hinge means.

Smith used a *ball-and-socket* type hinge with recessed openings in the body wall exposing the hinge arms. The structure never went into commercial use and was impractical for use on production cars. Plaintiff further points out that the ball-and-socket arrangement was actuated through a slot formed in the body wall and was exposed to the elements, exterior of the body wall. Smith's door, suspended by two too slender rods, would be bound to sag.

283 In the *Howe* v. *Atwood* decision (47 F. Supp. 979 (E. D. Mich. 1942)), Judge Frank A. Picard distinguished the Smith patent from the Howe patent, noting, at 987:

> "Thus we find the Smith patent distinguishing its 'ball and socket' feature on an inclined axis as accomplishing a result not obtainable by 'pintles' and insisting that pintles could *not* be used on the new

doors without at least one or more of the hinges being *exposed* and adding that alignment was difficult. In practice, however, defendants found that their own Smith hinge was not feasible because the Smith ball and socket arrangement would not support a heavy car door and discontinued its manufacture.

"We do not question that the Smith patent was a pioneer in the inclined axis hinge type but there is more to the Howe hinge than an inclined axis. The pintles themselves are inclined. Even in the drawing accompaying the second hinge in which there are two pintles, both the top and bottom pintles are inclined in complete alignment. The claims are all specifically based on an inclined pintle built into the hinge and Claims 3 and 4 are additionally based on a gooseneck-hinge member of substantial curvature varying the extent of curvature from top to bottom to compensate for the inclination of the pintle." (Italics added.)

The court also said, at 988:

"* * * [T]his court holds that the examiner and the government intended to give plaintiff a patent covering a hinge having a gooseneck type hinge member with an inclined axis and an inclined pintle."

It further said, at 989:

"It is our holding that where there were hinges with the pintles inclined and aligned on an inclined axis fitted upon a door or in a depression of the door pillar to obtain results of the Howe patent made and sold by defendant, plaintiff may recover. This we hold whether in a duplex unitary type or in a single type hinge."

The court concluded that it was not passing upon validity of the Howe patent, but upon infringement.

284 Mr. Hedeen testified that Smith had a tumble-in type body with inward and forward inclination, and a ball-and-socket hinge inclosed in the body of the door but a portion exposed on the outer surface—a cover plate. Further, there is a compensating angle of inclination of the

hinge axis. And, Smith notes that the length of the hinge arms is different. Hedeen stated the only thing Howe adds to Smith is the gooseneck hinge.

On cross-examination, Mr. Hedeen stated the Smith vehicle never went into production and that the hinge, while workable, would not be practical for high production cars because too expensive.

Defendant argues that plaintiff cites only the insignificant features of Smith; that, in fact, Smith discloses substantially concealed hinges and a door having a tumble-in curvature more "severe" than Howe's, and Smith solved this problem by inclining the axis forwardly. Smith "anticipates Howe in all respects except as to the specific type of the hinge," and it would have been "obvious to a man skilled in the art to take the Richard gooseneck hinges or the 1917 Chevrolet gooseneck hinges or the 1924-1925 Oakland gooseneck hinges and apply the Smith teachings thereto to achieve the same result as Howe does with a gooseneck hinge."

Contentions of the Parties.

Plaintiff stresses that the '490 patent is *not* limited to a unitary hinge and is not limited to a forward inclination of the hinge means to compensate for an inward inclination of the structure; nor as claiming hinge means, portions of which are exposed. On the contrary, the claims 285 all call for a *concealed* hinge. Concealment is one of the most important objects of the invention. Therefore prior art hinges which are not fully concealed do not anticipate. Infringement arises from the installation of the hinge in an automobile because the Howe patent does not contemplate simply a hinge, but a hinge for use in an automobile. But even if the patent were limited to a unitary structure, defendant's two-part structure would

still infringe (*Sutherland Paper Co.* v. *Auburn*, 118 F. 2d 862, 864 (7th Cir. 1941)). Nor, plaintiff states, can his claims be construed to be limited to a gooseneck-type hinge —a butt-type hinge would also be within the claims. Claims 1 and 2 are not limited to gooseneck hinges whereas Claims 3 and 4 are so limited.

Plaintiff cites the phrasing of the claims and specifications indicative of complete concealment of the hinge.

It is emphasized by plaintiff that although gooseneck hinges for use on automobiles were old as shown by Richard, Feldwabel, Mouche, Soss, Carr, 1917 Chevrolet, 1924-5 Oakland, and 1939 B. O. P., *concealed* gooseneck hinges on *inclined* car door walls were not suggested in the prior art and were considered by the prior art to be unusable. Prior to 1920, the cars were roadsters or touring cars, some with no doors at all, and the doors had no hinging problems. They had no glass and were light weight.

All steel bodies came in in the early 1930's, and the "tumble-in" bodies were adopted. The doors were larger and heavier and hung at an angle, and being inclined
286 would tend to slam from the force of gravity. The growing width of the doors made the "lift" when they were inclined unsightly and undesirable, so efforts were made to cause such inclined doors to swing more horizontally and so with less effort.

Mr. Howe testified that a forward inclination causes a drop of the door on opening which in part compensates for the lift resulting from inward inclination with the result the door will swing more horizontally than otherwise. Plaintiff maintains it is immaterial at what portion of the swing the rise and drop occur so long as the final result is one of substantially horizontal movement with no excessive lift.

Plaintiff claims an invention date earlier than June 7,

1937, when he disclosed his invention to the Assistant Director of New Devices Committee of defendant, evidenced by a drawing dated April 26, 1937, and identified by two signatures dated April 29, 1937. Another drawing of Howe, which he took to have made into a model by Paul Henze of Detroit on September 1, 1937, disclosed the subject matter of the instant patent. It was returned by Henze with a note on the back dated September 2, 1937. Mr. Howe made a layout drawing in 1938 for his licensee, Metal Specialty Company, for submission to M. Hughes, Chief Body Engineer of Studebaker, writing Mr. Hughes a letter dated May 11, 1938. The drawings Howe made for the licensee are also dated earlier in 1938 than defendant's B. O. P. public announcement. So Howe insists he had disclosed his invention to the public long before the 1939 B. O. P. was shown and has proved it by satisfying evidence
287 (*Marconi Wireless Telegraph Co. of America* v. *United States,* 320 U. S. 1, 34 (1943).

As to DX 49-37 (the letter charging General Motors with infringement), plaintiff maintains defendant seeks to twist it into an assertion by plaintiff that the patent in suit covers *partially* concealed hinges. Plaintiff explains that the letter specifies "*patents*" without giving their numbers and, in fact, it concerned *two* patents of plaintiff, the other one of which covered partially concealed hinges.

Plaintiff maintains that the scope of the Howe patent is to be determined by the patent grant and its file wrapper, and not by matters appearing in the *Howe* v. *Atwood* litigation. An inventor himself, Howe points out, may not be cognizant of the breadth or principles of his own invention (*Eames* v. *Andrews,* 122 U. S. 40, 56 (1887)). An inventor cannot change the patent's scope by what he may say. He believes that his letter (DX 49-37) is being used to misinterpret the scope of his patent as to partially concealed

hinges, when in fact the letter was meant to cover his earlier patent, No. 2,163,323, as well as the patent in suit.

Also, Howe points out that "obviousness" of an invention must be tested as of the time of its conception and not from hindsight (*Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U. S. 428, 435 (1911)). He argues that defendant relies on prior art for anticipation but did not itself choose to follow it until it had knowledge of plaintiff's work.

288 Plaintiff argues strenuously that the Atwood litigation does not constitute an estoppel in that General Motors was not a party to that litigation or in privity. All it did was furnish Atwood with material for defense. Further, the issue in the Atwood case was not infringement of the patent but *construction of a license agreement.*

Defendant states its interest in the Atwood litigation is *Howe's* then interpretation of his own patent—that it covered a single hinge that was concealed but was used at the top of the door in conjunction with a lower exposed conventional hinge (such as the 1939 B. O. P.). He is now saying the patent does not cover a single concealed hinge but only two concealed hinges used in concert.

Howe testified he had four pending applications, no patents, at the time of the Atwood license.

Infringement is present, plaintiff contends, because in the accused passenger car structures, the hinges are mounted as to be fully concealed within the door and the door pillar and built within the contours thereof both inside and outside of the car body. None is merely hidden from view with a shield such as the model of the 35 XP 510 drawing. In almost all of the structures the reach at the top of the hinge structure is longer than that at the lower portion thereof. The longer hinge reach at the top causes the door edge to swing further away from the door opening at that portion than at the connection with the shorter

hinge portion, and is a factor helping to compensate
289 for and solve the problem caused by inclined walls of tumble-in bodies of automobiles. All of the alleged infringing devices have their axis inclinations tilted inwardly at the top, none is either vertical nor tipped outwardly at the top. Most of them have their axis inclined forwardly as well. A couple of the devices have very slight rearward inclination. Plaintiff further insists that in all the accused structures "there was a swing 'through a substantially horizontal arc' and without excessive lift." None of the accused hinges is mounted at the rear. Not all of the accused structures are charged to infringe all the claims.

It is defendant's contention that the Howe patent is invalid because completely and directly anticipated by any one of the prior art Mouche and Carr patents, the Feldwabel publication, and the 1939 B. O. P. upper front door hinge; that what Howe did was obvious. Further, it contends that the patent claims define an aggregation of old elements all performing the same function in combination which they performed previously, with no new or surprising consequences (*Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950)).

Inasmuch as this prior art and the Richard patent and defendant's 1917-1918 Chevrolet hinges, and the 1924-1925 Oakland hinges were not cited by the Patent Office Examiner, the presumption of validity arising from the grant of the patent "is greatly weakened" (*Kennatrack Corporation* v. *Stanley Works*, 314 F. 2d 164 (7th Cir. 1963); *Milton Manufacturing Co.* v. *Potter-Weil Corporation*, 327 F. 2d 437 (7th Cir. 1964)).

290 Defendant further insists there was no "hinging problem" which had to be solved, dealing with steel bodies, full doors, and closed doors, which plaintiff discusses in his brief, but which the patent itself failed to mention. In

fact, the defendant asserts it had long used spaced pairs of concealed gooseneck hinges on inclined axes on open cars where the hinging is all below the belt line. It had, prior to Howe, used completely concealed spaced gooseneck hinges on an inwardly ~~and forwardly~~ inclined axis to support the rear door of the 1939 B. O. P. closed sedan having glass in the door and where the hinging was still all below the belt line. The ~~front~~ rear door of the 1939 B. O. P. closed sedan was thereby caused to swing in a substantially horizontal arc. If there were invention, defendant and its employees were the prior inventors as shown by 35 XP 510 and 1939 B. O. P.

Defendant states that in order to avoid the anticipating prior art—the Mouche patent, the Feldwabel publication and the 1939 B. O. P. and 35 XP 510 hinging—Howe attempts to read limitations into his broad claims by excluding from the patent open touring cars or roadsters having light weight narrow doors and including only closed sedans which have larger, heavier doors with glass. However, nowhere (except in the drawing) does Howe state therein that his patent is so limited. This reading of nonexistent limitations into the claims is in effect applying a double standard in an effort to save the patent over the prior art and at the same time to read claims on accused
291 hinges which is not allowed (*Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. 2d 812 (7th Cir. 1943); *Enterprise Railway Equipment Co.* v. *Pullman Standard Car Mfg. Co.*, 95 F. 2d 17, 21 (7th Cir. 1938)). Nor is plaintiff interpreting his patent by the same standard in determining validity as for determining infringement (*White* v. *Dunbar*, 119 U. S. 47, 51-52 (1886)).

Defendant also challenges plaintiff's argument that his patent is limited to a completely concealed hinge in order to avoid anticipation by the 1939 B. O. P. defense and a limitation may not be read into a broad claim to save it

from anticipation (*McCarty* v. *Lehigh Valley Railroad Co.*, 160 U. S. 110, 116 (1895)).

Defendant insists the Howe patent nowhere claims that the variation in hinge lengths is another means for causing the door to swing in a substantially horizontal arc. Defendant maintains that it has been conclusively demonstrated that varying the length of the hinge arm has no effect on door swing and it is only the hinge axis and the angles of the hinge axis that control the swing of the door.

Defendant contends that the Howe patent is invalid for indefiniteness in many critical respects both in the specification and claims, and does not state the limits of the invention as required by 35 U. S. C. § 112. There must be guide lines so the public will be advised as to what would constitute infringement (*General Electric Co.* v. *Wabash Appliance Corp.*, 304 U. S. 364, 368 (1938); *United Carbon Co.* v. *Binney Co.*, 317 U. S. 228, 236-237 (1942)). Among other deficiencies, the degree of forward inclination
292 to compensate for the inward inclination so as to cause the door to swing in a substantially horizontal arc is not given. Howe testified there might be a difference of engineering opinion as to what is excessive lift and excessive tumble-in. This itself is a basis for invalidity of claims (*A R Inc.* v. *Electro-Voice, Incorporated*, 311 F. 2d 508 (7th Cir. 1962)).

Defendant claims its 35 XP 510 in 1935 antedates plaintiff's earliest invention date, and the burden of proof in carrying back dates of invention is equally as heavy on a plaintiff patentee as it is on a defendant, and it is also required in this circuit and elsewhere that the inventor's testimony be corroborated, which Howe failed to do (*Pleatmaster, Inc.* v. *Golding Mfg. Co.*, 240 F. 2d 894, 898 (7th Cir. 1957)).

Defendant claims that not one of its doors is hinged at

the rear edge and so it cannot be deemed to infringe Claim 3, which described an axis inclined inwardly and rearwardly.

Mr. Hedeen methodically covered the accused infringing structures and found support for them in the prior art, and similarly found anticipation of the Howe patent therefrom.

Infringement where the structure is readily understandable is a question for the court to determine and expert testimony on the issue is not needed, and is in fact superfluous, defendant points out (*Singer* v. *Cramer,* 192 U. S. 265, 275 (1904); *Thabet Mfg. Co.* v. *Kool Vent Metal Awning Corp.,* 226 F. 2d 207 (6th Cir. 1955); *Kohn* v. *Eimer,* 265 Fed. 900 (1920)). Further, the mere reading by
293 Howe of his patent claims on the accused hinges does not establish infringement, because to infringe there must be real identity of means, operation and result (*Flowers* v. *Austin-Western Co.,* 149 F. 2d 955 (7th Cir. 1945); *Elgen Mfg. Corporation* v. *Ventfabrics, Inc.,* 314 F. 2d 440 (7th Cir. 1963); *North Star Ice Equipment Co.* v. *Akshun Manufacturing Co.,* 301 F. 2d 882 (7th Cir. 1962); *Weil Pump Co.* v. *Chicago Pump Co.,* 74 F. 2d 13 (7th Cir. 1934)). The claims cannot be given a broader construction than the actual teachings of the patent as shown by the drawings and the specifications (*Flowers* v. *Austin-Western Co.,* supra; *Weil Pump Co.* v. *Chicago Pump Co., supra*). And Howe's advance, if any, stated in his claims being in a crowded art, must be strictly construed (*Computing Scale Co.* v. *Automatic Scale Co.,* 204 U. S. 609 (1907); *Simmons Company* v. *Brandwein & Co.,* 250 F. 2d 440 (7th Cir. 1957); *Kennatrack Corporation* v. *Stanley Works,* 314 F. 2d 164 (7th Cir. 1963)). Defendant insists the axis of its hinges are determined by the body of the car, i.e., the styling of the car determines the inclination. It states, "after a body is styled, the hinge axis and length of hinge arms just happen."

Defendant further emphasizes that none of the accused structures is a *single* hinge as called for by the Howe claims. Also, some accused structures were inclined only inwardly and did not swing in a substantially horizontal arc causing the door rise to be excessive. In fact, a divergence in length of hinge arms does not affect door rise—only the inclination of hinge axis can do that. Since, as Judge La Buy found, all the claims call for a dual inclination
294 of the hinge axis, the accused structures which incline only inwardly cannot be deemed to infringe. Since plaintiff formulated the finding, he is bound by that interpretation of his patent. Further, those structures of defendant which have an inward and *rearward* inclination, cannot be deemed to infringe because there are additive angles which increase the door's tendency to rise on being opened, rather than making it swing in a substantially horizontal arc.

As to other of its hinges, defendant denies infringement because the inclination inwardly is so great as to make a door rise of some six and a half inches. Such a high door rise could not be said to constitute a substantially horizontal arc. Those hinges having but a very slight door rise do not infringe because the inclination was not directed to an excessive door rise but was dictated by body styling. Some of its hinges have an axis parallel with the door edge so do not constitute infringement, because the omission of a feature or structural relationship in a claim will avoid infringement (*Kennatrack Corporation* v. *Stanley Works*, 314 F. 2d 164 (7th Cir. 1963)).

Defendant says that Feldwabel found Howe's solution —but in the reverse—because the body in the Feldwabel vehicle inclined outwardly.

Defendant rejects any plausible basis of validity of Howe's patent over the prior art based on the prior art

having no glass and no frame above the belt because all the hinging in the prior art was below the belt line.

295 As to prior litigation, defendant points out the Carr patent, the Feldwabel publication and the B. O. P. defense were not before Judge La Buy in the trial before him. Defendant also challenges plaintiff's reliability citing the inconsistency of his position in the present case from that in the *Howe* v. *Atwood* matter.

Conclusion.

The determination of the issue of validity is not as clear-cut as might be desired. The court, however, concludes that in view of the state of the prior art the advance covered by the patent should have been "obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" (*Graham et al.* v. *John Deere Company of Kansas City, et al.*, Nos. 11, 37 and 43, decided February 21, 1966, United States Supreme Court). While the Supreme Court states that "the general level of innovation necessary to sustain patentability remains the same," still it is further observed, "The grant of an exclusive right to an invention . . . was not to be freely given." It said:

> "* * * Jefferson did not believe in granting patents for small details, obvious improvements, or frivolous devices. His writings evidence his insistence upon a *high level of patentability.*"
>
> * * * * *
>
> "* * * Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of

296 others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . . ."

* * * * *

"* * * [T]he inquiry which the . . . courts must make as to patentability must be beamed with greater intensity on the requirements of § 103, it bears repeating that we find no change in *the general strictness* with which the overall test is to be applied. We have been urged to find in § 103 a relaxed standard. . . . The standard has remained invariable in this Court. . . . He who seeks to build a better mousetrap today has a long path to tread before reaching the Patent Office."

* * * * *

"The District Court and the Court of Appeals found that the prior art 'as a whole in one form or another contains all of the mechanical elements of the . . . Patent'." (Italics added.)

In commenting on the step taken in the matter there being considered, the court said:

"* * * Certainly a person having ordinary skill in the prior art, given the fact that the flex in the shank could be utilized more effectively if allowed to run the entire length of th shank, would immediately see that the thing to do was what Graham did, i.e., *invert* the shank and the hinge plate."

* * * * *

"* * * Furthermore, *even though the position of the shank and hinge plate appears reversed in Glencoe, the mechanical operation is identical.* The shank there pivots about the underside of the stirrup, which in Glencoe is *above* the shank. In other words, the stirrup in Glencoe serves exactly the same function as the heel of the hinge plate in '798. The mere shifting of the wear point to the heel of the '798 hinge plate from the stirrup of Glencoe . . . presents no operative mechanical distinctions, much less nonobvious differences." (Italics added.)

297 The court has considered plaintiff's argument that this invention can not be deemed obvious when defendant had hundreds of skilled men working many months with all the prior art at their disposal, and yet they did not come up with his solution of the inclination of the hinge means forwardly and inwardly, using a gooseneck hinge with the upper arm longer than the lower one to accommodate the resultant wider swing on top than on the bottom due to the inclination of the axis. As plaintiff points out, defendant used a partially, not a completely concealed hinge, and did not utilize prior art knowledge until plaintiff made his alleged disclosure to it.

It is apparent, however, under the *Graham* decision, *supra*, that a mere reversal of the inclination of the axis of the prior art on tumble-out auto bodies would be deemed an obvious change, not arising to the dignity of invention. Similarly, the utilization of the old gooseneck type hinge with a variation in arm length adapted to the change in inclination of the axis would also be a manifestation of mechanical skill.

It should have been clear to a skilled worker in the field that if the axis of a hinge on an outwardly inclined car body was outwardly inclined that when the auto body line was changed to curve inwardly, the axis of the hinge would undergo a comparable change. And it would follow that the arms of the gooseneck hinge would also have to be reversed with the longer one on top and the shorter one on the bottom. The Mouche patent and the Feldwabel article showed practically the inverse of plaintiff's conception, on a tumble-out body. Carr had a gooseneck hinge with arms of differing lengths.

298 The court concludes that the Howe '490 patent is invalid because not evidencing an advance sufficiently great over the prior art to be the basis of a valid patent. It therefore need not pass upon the issue of infringement.

Counsel for defendant is directed to prepare and submit to the court and opposing counsel, within ten days, findings of fact and conclusions of law, which shall simply state the adoption by the court of the facts disclosed in the stipulation of facts, the findings of this decision, and the conclusion of law of invalidity of the patent.

Edwin A. Robson,
Judge.

April 5, 1966.

299 UNITED STATES DISTRICT COURT.

Northern District of Illinois,

Eastern Division.

Name of Presiding Judge, Honorable Edwin A. Robson.

Cause No. 54 C 1893 Date Apr. 5, 1966

Title of Cause Earl E. Howe *vs.* General Motors Corporation.

Pursuant to Decision on the Merits filed herewith order deft. to prepare and submit to court and opposing counsel w/in 10 days, Findings of Fact, etc. as set forth in Decision. Robson, J., Apr. 6, 1966.

In the
United States Court of Appeals
For the Seventh Circuit

SEPTEMBER TERM, 1967 — JANUARY, 1968 SESSION

Nos. 15841, 15842
EARL E. HOWE,
Plaintiff-Appellant-Appellee,
v.
GENERAL MOTORS CORPORATION,
Defendant-Appellee-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

JULY 15, 1968

Before CASTLE, *Chief Judge,* KILEY and FAIRCHILD, *Circuit Judges.*

FAIRCHILD, *Circuit Judge.* Earl E. Howe brought this action in 1954 against General Motors Corporation to recover treble damages for infringement of a patent.[1] At issue are alleged infringements from 1948, six years before commencement of the action, to 1957, when the patent expired.

Defendant alleged laches and estoppel, among other defenses. Plaintiff had demanded a jury trial, and in 1958 this equitable defense was tried before Judge La Buy without a jury. Judge La Buy decided that defendant failed to prove laches or estoppel.[2] The other issues were tried in 1960, but the jury could not agree.

[1] No. 2,201,490, Inclined Hinge, issued May 21, 1940, to Earl E. Howe, application dated January 9, 1939.

[2] *Howe v. General Motors Corporation* (N.D. Ill. 1958), 167 F.Supp. 330.

The case was tried again in March and April, 1961. The jury found for defendant, but Judge Perry granted a new trial. This court denied defendant's applications for certiorari or mandamus.[3]

The demand for jury trial was withdrawn, and the case was tried before Judge Robson, without a jury. Judge Robson filed an extensive opinion[4] as well as findings of fact and conclusions of law, holding the patent invalid for obviousness under 35 U.S.C. sec. 103.

Plaintiff has appealed from the judgment accordingly entered. Defendant has appealed from the 1958 order dismissing its defense of laches and estoppel, the 1961 order granting a new trial, and the 1961 order denying its motions for a directed verdict. These latter challenges need not be considered if the judgment be affirmed on plaintiff's appeal.

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The trial occurred before announcement of *Graham* v. *John Deere Co.*[5] and the decision was prepared shortly thereafter. As a result the analytical steps prescribed in *Graham* for resolution of the obviousness issue were not as meticulously set forth as is desirable.[6] We are satisfied, however, that the court did apply the correct tests and reached the proper result.[7]

1. *The problem addressed by plaintiff.* Plaintiff prepared his application in the latter 1930's. All-steel bodies had earlier begun to be prevalent. Designers found it desirable to shape them with curved side walls, usually inclined toward the interior as they extended upward (the so-called "tumble-in" body shape). The doors were heavy and must be hinged so as to swing free of the adjacent curved edges of the body. Sturdy hinges were necessary. It is undesirable to have a door so hinged that the force of gravity will make it difficult to open or will cause it to shut with dangerous force when open. On the

[3] *General Motors Corporation* v. *Perry* (7th Cir. 1962), 303 F.2d 544.

[4] *Howe* v. *General Motors Corporation* (N.D. Ill. 1966), 252 F.Supp. 924.

[5] (1966), 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545.

[6] See *Cloud* v. *Standard Packaging Corp.* (7th Cir. 1967), 376 F.2d 384, 391, and *Gass* v. *Montgomery Ward & Co.* (7th Cir. 1967), 387 F.2d 129, 130.

[7] Plaintiff challenges the court's use of "should have been obvious" in the reported opinion. In its findings, however, the court said "would have been obvious", as does the statute.

other hand a reasonable tendency to close, called a bias toward closing, is desirable. It is undesirable to have hinges protrude beyond the outer wall. These are some, but not all of the factors which are weighed in selecting a design.

Elements of the hinging problem are suggested in portions of Mr. Howe's application:

> "In an automobile body having upwardly converging side walls the door frame is, of course, inclined with the result that assembly of a hinge therein ordinarily disposes the hinge pin at an angle to the vertical. The angularity of the hinge pin is such that any point on the door swings through an arc which is inclined to the horizontal and inasmuch as the angle is such that gravity will cause the door to swing to its closed position, the angularity of the hinge pin is termed the tumble-in angle. The excessive tumble-in angle present in conjunction with the inclined walls of the later automobile body designs is undesirable in the respect that the door closes too rapidly and unless held may strike a person entering the automobile or who has completed his entrance except as to his foot and ankle. From the standpoint of appearance it is undesirable that the arc of swinging movement of the door should depart too great a degree from a horizontal plane. Accordingly, it is an important object of this invention to provide a concealed hinge which permits the door to swing substantially parallel to the ground, or in a substantially horizontal arc even in the presence of an extreme tumble-in angle.
>
> "Another object of the invention is to provide a concealed hinge for supporting an automobile door in such manner that gravity biases closing movement thereof. This feature is particularly desirable in conjunction with the left hand doors of an automobile in order that such doors will not remain open while the automobile is parked on a highway, as such doors in an open position constitute a hazard to traffic on the highway.
>
> "Another object is to provide a concealed hinge for supporting a curved door for swinging movement

about an axis which is disposed externally of the automobile body at both the top and the bottom of the door frame, and which passes through the body between the top and bottom of the frame. The purpose of the hinge in this respect is to avoid the necessity of comparatively long, outwardly projecting hinge elements, such as are ordinarily used in conjunction with curved doors. This is made possible by use of a single hinge, disposed within the plane of the body wall, and whose axis of pivotal movement if prolonged passes the top and bottom of the door frame externally thereof."

2. *Plaintiff's solution.* The patent contains four claims. Claim 2 reads as follows:

> "A concealed hinge for supporting a door from a door pillar in an automobile body having an inclined wall, said hinge comprising a plate member for attachment to the pillar, a pintle carried by said plate member disposed at an angle to the vertical as viewed in a transverse section through said wall, said plate member also supporting said pintle with its axis at an angle to the vertical as viewed in side elevation, an arm member connected to said pintle and adapted for attachment to a door, the axis of said pintle being inclined with respect to the adjacent edge of the door to the extent that said door swings through a substantially horizontal arc during opening and closing movements thereof, said arc departing from the horizontal only in an amount enabling gravity to bias movement of the door toward a closed position."

Claim 1 is identical to Claim 2 except that Claim 1 does not contain the last 22 words (beginning "said arc").

Claim 3 is somewhat similar in outline to Claim 2. It refers, however, to "a curved door on a curved automobile door pillar", to the hinge axis as inclining "inwardly of the automobile body and also rearwardly thereof with respect to the adjacent door edge", and to "a gooseneck hinge means of generally U shape—the U shape of said gooseneck member varying in length of its branch and in divergence from top to bottom thereof by an amount

sufficient to substantially compensate the inclination" of the axis.

Claim 4 is somewhat similar to Claim 3, but refers to the axis being "at an inclination to the vertical as required by the curvature of the automobile body. . . ."

The significant elements or devices described in one or more claims are concealment of the hinge, sloping the axis of the hinge pintle inwardly as it extends upwardly and either forwardly or rearwardly, and use of a gooseneck U shaped hinge arm so shaped as to allow for a greater distance between the axis and the point on the door to which that part or branch of the arm is connected than between the axis and the point on the door to which another part or branch of the arm is connected. Each claim specifies that the door "swings through a substantially horizontal arc."

Certain principles with respect to the inclination of the hinge axis clearly appear from the record:

If the hinge axis is vertical, a given point in the door will describe a horizontal arc when the door swings. If the hinge axis is inclined inwardly as it extends upward, but is inclined neither forwardly nor rearwardly, a given point in the door will rise as the door swings open toward 90°. If the axis is inclined inwardly and away from the door (forwardly if the door is hinged at its forward edge), a given point in the door will rise as the door swings partly open and then will fall. This is the effect described in every claim of the patent as swinging through a substantially horizontal arc. If the angle by which the axis is inclined inwardly is equal to the angle by which it is inclined away from the door, the change from rising to falling will occur when the door has swung open to 45°.

If the hinge axis is inclined inwardly and toward the door (rearwardly if the door is hinged at its forward edge), a given point in the door will rise at a faster rate as the door swings open toward 90° than if the only inclination were inwardly. This effect was referred to at trial as additive, rather than compensating.

If the hinge axis is inclined outwardly as it extends upward, but not inclined either forwardly or rearwardly,

a given point in the door will fall as the door swings open toward 90°. There will be a compensating effect if the axis is also inclined toward the door and an additive effect if away from the door.

As will be seen, concealed hinges and gooseneck hinge arms were known and used before this patent. The issue mainly debated here is whether the idea of inclining the hinge axis so as to achieve a compensating effect is old or obvious.[8]

Normally it is desirable to space the hinges relatively far apart along the axis. In the drawings included in the patent, Mr. Howe provided for a single unitary hinge, with a pintle apparently longer than the ordinary one, or with two pintles spaced slightly apart along the axis. Assuming this hinge could be made sturdy enough, the fact that it did not take up much space along the axis would work an advantage in fitting the hinging apparatus into one segment of a curved door. This idea, however, is not expressed in any claim.

3. *The prior art.* The patent contains no citations of prior art patents. Considerable proof in this area was produced on trial and is reflected in the opinion of the district court.[9]

Concealed, gooseneck, U shaped hinges were disclosed in the 1917 Chevrolet; in the Richard patent;[10] in the Feldwabel publication;[11] in the Soss patent;[12] in the Mouche patent;[13] and in the 1924 Oakland touring car.

[8] Literally, the claims apply whether the hinge axis be inclined inwardly or outwardly, although Mr. Howe stated the problem in terms of tumble-in bodies. Inclinations which produce an additive effect are outside the claims because each claim includes the element of swinging through a substantially horizontal axis.

[9] *Howe v. General Motors Corporation* (N.D. Ill. 1966), 252 F.Supp. 924, 927. We deem it unnecessary to repeat the details here.

[10] No. 1,325,109, Hinge Construction, issued December 16, 1919 to F. Richard on application filed March 10, 1917.

[11] Der Wagenbauer Lehr-und Hilfsbuch fur Wagenbau und Automobil-Karosserie, von J. Feldwabel, published in Germany and Austria in 1920. It was stipulated this was received in the United States early enough to be prior art.

[12] No. 1,363,270, Hinge, issued December 28, 1920 to C. J. Soss on application filed June 17, 1919.

[13] French patent No. 537011, Hinge retaining the vertical position during the opening of a door having a curvilinear profile vertically, issued February 23, 1922 to Elie Mouche on application filed June 4, 1921.

The Feldwabel publication and the Mouche patent also disclosed variations in the size or curvature of the goose-neck hinge member, required in order to accommodate the curved vertical profile of the door to the hinge axis.

Diagonal inclinations of the hinge axis, producing the compensating effect, was disclosed by the Feldwabel publication, the Mouche patent, and the Smith patent,[14] and was suggested as a possibility by the Carr patent.[15]

Table 25 of the Feldwabel shows an open car. The hinge axis of the door is inclined outwardly as it extends upward (a tumble-out type). The axis is also inclined rearwardly (toward the door), thus producing the compensating effect.

The Mouche patent disclosed a tumble-out body, with hinge axis inclined outwardly and rearwardly (toward the door), and producing the compensating effect.

The Carr patent depicted a door hinged at its rear edge. The hinge axis had a substantial inclination rearwardly as it extended upward. Carr preferred no lateral inclination, but indicated the axis might be inclined either inward or outward.

Carr, Feldwabel, and Mouche do not expressly describe the effect of inclination of the hinge axis upon the swing of the door, except that some language of Mouche indicates that his arrangement results in the door remaining vertical as it opens.

The Smith patent, however, though using a type of hinge different from Howe, expressly refers to the effect of diagonal inward inclination of the hinge axis. Smith says, in part:

> "By varying the relative lengths of the hinge plates and connector members, various characteristic door movements may be obtained. For instance, the plates and connector members may be so constructed and adjusted for bodies having walls and doors of any particular contour or shape that the axis about which the door hinges may be perpendicular or in-

[14] No. 2,050,409, Vehicle Door Mounting, issued August 11, 1936 to F. M. Smith on application filed September 5, 1935.

[15] No. 2,114,830, Vehicle, issued April 19, 1938, to R. L. Carr on application filed January 15, 1935.

clined forwardly, rearwardly or laterally relative thereto, whereby the door will tend to remain in any partly opened or wholly opened position or if inclined will tend to move to either opened or closed position, depending upon the direction of inclination of such axis.

"In order that the top and bottom edges of the door shall remain more nearly horizontal or parallel with the ground level when the door is opened, the hinge joint of the upper hinge is offset longitudinally of the vehicle to compensate for this inward inclination of the hinge axis. The hinge axis of the door is, therefore, diagonally inclined, that is, it is inclined both transversely and longitudinally of the vehicle. As a result of this diagonal inclination of the hinge axis, the door, when opened, will, in theory, tend to close until it is turned to the neutral position in the vertical plane of the hinge axis and beyond that it tends to swing to open position."

Smith's Claim 14 reads:

"In combination, a vehicle body ovate in cross section, a door for said body, upper and lower hinges for hingedly connecting said door to said body, the axis of the joints of said hinges extending diagonally inward whereby said door will tend to close when released at one side of the neutral position of said door, and will tend to open when at the opposite side of the neutral position."

4. *Differences between the prior art and the claims.* With respect to the type of hinge, its arrangement so as to be concealed, and its configuration so as to accommodate doors with a curved vertical profile, or otherwise having an edge not parallel to the hinge axis, the Howe patent does not differ from corresponding elements of the prior art. Howe was concerned with heavier doors, but resulting differences in size and strength of hinges would be immaterial for the present purpose. The district court found:

"The technique of hinging of doors to the bodies of touring cars, convertibles and closed cars or sedans is the same because the hinging of a car door and its hinge axis is dependent upon the contour

of the door and body surface below the belt line. The size and weight of the doors and the use of glass above the belt line do not affect the hinge axis. Howe did not urge before the Patent Office that the technique of hinging doors on closed cars was different from that of hinging doors on open touring cars which he so heavily relied upon at the trial."

With respect to the inclination of the hinge axis and its effect on the swinging of the door, some of the prior art is found in tumble-out bodies, whereas Howe was concerned with a corresponding effect in tumble-in bodies. The district court found:

"The problem of compensating for an inward inclination of the hinge axis in the transverse view in a tumble-in body to achieve a substantially horizontal door swing is the inverse of the problem of compensating for an outward inclination of the hinge axis in the transverse view in a tumble-out body and the solution of the problem is the same in each instance. Where there is an outward inclination of the hinge axis, the hinge axis is inclined rearwardly to compensate for it and achieve a substantially horizontal door swing. Where there is an inward inclination of the hinge axis, the hinge axis is then inclined forwardly to compensate for the inward inclination and this also causes the door to swing in a substantially horizontal arc."

The Smith patent disclosed a ball-in-socket hinge and not the pintle type described by Howe. The Smith hinge was not as fully concealed as Howe's. Both, however, were concerned with the tumble-in bodies prevalent in the latter 1930's. There is no material difference between their concepts of the inclination of the hinge axis and its effect on the swinging of the door.

There are combinations of concealed, gooseneck, U shaped hinges and diagonal inclination of the hinge axis, with compensating effect, in the tumble-out prior art. Defendant did not prove, as prior art, any similar combination in tumble-in bodies.[16]

[16] One possible, partial exception, not relied on, is the so-called 1939 B.O.P. hinging, which will later be referred to.

5. *The level of ordinary skill in the pertinent art.* It appears that in the late 1930's the level of ordinary skill in the field of designing automobile bodies, including hinges, was that of engineers of substantial training, and specialized skill.

6. *Obviousness.* It is perhaps possible to say that the Howe patent claims were anticipated by the tumble-out prior art. But in any event, viewing the subject matter of the patent either as an inversion of the tumble-out prior art, to adapt it to tumble-in bodies, or as a combination of the well-known type of concealed hinge with the diagonal inclination of axis disclosed by Smith, we conclude that the subject matter would have been obvious to a person having ordinary skill in the art.

Mr. Howe, of course, emphasizes the fact that no automobile manufacturer, before the time of his patent, produced a closed car with a tumble-in body, with all hinges concealed. This type of fact is referred to by the Supreme Court in *Graham* as relevant, but secondary. It would be more persuasive here if the record had satisfactorily shown that the problem, addressed by Mr. Howe, of accommodating a desirable pattern of door swing to an inclined hinge axis, was really the stumbling block for a substantial period. It is not surprising that the record fails to illuminate this point. The pertinent period was more than 25 years before the most recent trial, and, indeed, more than 15 years before Mr. Howe began the action.

We acknowledge the statutory presumption of validity of a patent.[17] It has little, if any, force as against relevant prior art not shown to have been considered by the patent office.[18] In our view the presumption has been overcome.

Other issues. We affirm the district court decision on invalidity because of obviousness. It is unnecessary to review the issues raised by defendant's appeal. It is also

[17] 35 U.S.C. sec. 282.

[18] *Skirrow* v. *Roberts Colonial House, Inc.* (7th Cir. 1956), 361 F.2d 388, 390; *Novo Industrial Corporation* v. *Standard Screw Company* (7th Cir. 1967), 374 F.2d 824, 877, *Cf. Hunt* v. *Armour & Co.* (7th Cir. 1950), 185 F.2d 722, 726; *Kennatrack Corporation* v. *Stanley Works* (7th Cir. 1963), 314 F.2d 164; *Milton Manufacturing Co.* v. *Potter-Weil Corporation* (7th Cir. 1964), 327 F.2d 437.

unnecessary to consider the hinging on defendant's 1939 Buicks, Oldsmobiles, and Pontiacs (1939 B.O.P.).

The 1939 B.O.P. upper front door hinge was concealed and the axis was inclined inwardly and forwardly (away from the door). The hinge was developed in or prior to 1938 when the 1939 models were first sold. They were sold before Howe filed his application. Plaintiff has claimed that his invention was earlier and that in developing this hinge defendant's representatives used information given them by plaintiff. Defendant has claimed that its development of this hinge began in 1935 and that if there is invention, defendant's 1939 B.O.P. hinge is invention prior to plaintiff's. The facts are in dispute and need not be resolved in view of our conclusion that the patent is invalid for obviousness.

The judgment appealed from is affirmed.

A true Copy:

Teste:

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Clerk of the United States Court of Appeals for the Seventh Circuit.

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STATUTES.

UNITED STATES CODE

TITLE 5 ADMINISTRATIVE PROCEDURE ACT

Sec. 1: The provisions of this title shall apply to...the Dept. of Commerce

Sec. 597: The following named offices ..shall be under the jurisdiction and supervision of the Dept, of Commerce:...The Patent Office.

Sec.1001: Definitions. As used in this chapter (a) Agency. "Agency means each authority (whether or not within or subject to review by another agency) of the Government of the United States, other than Congress, the courts.....

Sec.1009: Judicial review of agency action. Except so far as (1) statutes preclude judicial review or (2) agency action is by law committed to agency discretion— (a) Right of Review. Any person suffering legal wrong because of any agency action, or adversely affected or aggrieved by such action within the meaning of any relevant statute, shall be entitled to judicial review thereof..... (e)Scope of review. So far as necessary to decision and where presented , the reviewing court shall decide all relevant questions of law,interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of any agency action. It shall ....(B) hold unlawful and set aside agency action ...found to be (1) arbitrary, capricious,an abuse of discretion ...(5) unsupported by substantial evidence in any case (on review of the record provided by 35 U.S.C. s. 141); or (6) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court (provided by 35 U.S.C. s. 145)....

TITLE 35 PATENT ACT

Section 101: Inventions Patentable: Whoever invents or discovers any new and useful ...manufacture...or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Section 102:Conditions for Patentability;Novelty and loss of right. A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * * * * * * * *

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it.....

Section 103: Conditions for Patentability; NON-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

TITLE 35 PATENT ACT. Chapter 13 - REVIEW OF PATENT OFFICE DECISION

Sec. 141: Appeal to Court of Customs and Patent Appeals. An applicant, dissatisfied with the decision of the Board of Appeals, may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title.....

Sec. 145. Civil Action to Obtain Patent. An applicant, dissatisfied with the decision of the Board of Appeals, may, unless an appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court of the District of Columbia, ... The Court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law.....

Section 282. PRESUMPTION OF VALIDITY. A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on the party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

* * * * * * *

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

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